

No. 12,540

IN THE

United States Court of Appeals
For the Ninth Circuit

JACUZZI BROS., INCORPORATED
(a Corporation),

Appellant,

vs.

BERKELEY PUMP COMPANY (a Corporation), BERKELEY PUMP COMPANY (a Partnership), and FRED A. CARPENTER, LANA L. CARPENTER, F. F. STADELHOFFER, ESTELLE E. STADELHOFFER, JACK L. CHAMBERS, WYNNIE T. CHAMBERS, CLEMENS W. LAUFENBERG and MARIE C. LAUFENBERG, partners associated in business under the fictitious name and style of Berkeley Pump Company,

Appellees.

BRIEF ON BEHALF OF APPELLEES.

FILED

OCT 27 1950

AUL P. O'BRIEN,

CLERK

5th Floor, 391 Sutter Street, San Francisco 8, California,

MELLIN, HANSCOM & HURSH,
OSCAR A. MELLIN,
LEROY HANSCOM,
JACK E. HURSH,

Attorneys for Appellees.

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The first part of the history of the city of Boston is devoted to a description of the city and its surrounding territory. It is divided into three books, the first of which describes the city and its surrounding territory, the second describes the city and its surrounding territory, and the third describes the city and its surrounding territory.

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Appellees.

BRIEF ON BEHALF OF APPELLEES.

SUMMARY OF THE ARGUMENT.

The findings of the District Court on the questions of novelty, anticipation, lack of invention, lack of patentable combination, and invalidity, being findings of fact, should not be set aside since they are

not clearly erroneous and are supported not only by substantial evidence but by the overwhelming weight of the evidence.

Appellant's contention that this Court of Appeals should give *de novo* consideration to the evidence and should review the prior art in disregard of the findings of fact of the District Court should be rejected. The trial Court held the patents totally invalid on several independent grounds, to-wit, lack of patentable invention, complete anticipation by the prior art, that the claims of the patents do not comply with R.S. 4888, and that the later issued of the two patents in suit was invalid for double patenting. The fact that the Patent Office issued the patents and the District Court found them invalid *is not such a conflict as should require this Court to give de novo consideration to the evidence and to the prior art.*

The patents here in suit do not come before this Court with any presumption of validity in that pertinent art relied upon by the District Court in finding lack of invention and invalidity was not before the Patent Office and the Patent Office did not refer thereto.

Appellant's argument in its brief, by which it attempts to bolster and prop up the invalid patents by clothing them with functional advantages and features which the record discloses and the District Court found to be old and present in prior art pumps, is based on false premises and finds no basis of fact in the record.

The pumps here in issue did not supplant or take the place of prior pumps, but at most merely supplemented the older line of pumps and did not supersede them or render them obsolete. The pumps at issue are merely the result of a continuous application of engineering skill to adapt existing pumps to progressing conditions such as the deepening of water wells in the state.

The step which appellant claims the patentees have taken and which is contended to be a patentable invention in the patents was merely to change prior water pumping systems only in degree and not in kind or character.

The prior art shows and the District Court found that pumps with selective or dual discharge, one at a lower stage than the other, are admittedly old and the substitution of such an old pump for the single discharge pump of prior water systems is not invention and involved at most no more than mechanical skill.

The pumping system shown in the Veronesi 1913 patent, Exhibit M (which was not before the Patent Office when they considered the patents in suit) completely nullifies any claim of novelty or invention of the patents in suit. The only difference between the pump shown in this Veronesi 1913 patent and the pumping systems of the patents in suit (as conclusively proven by the only evidence and the findings of fact of the Court) is the details of construction of the centrifugal pump which do not alter the

mode of operation or the result of the pumping system.

The Veronesi 1927 patent, Exhibit N, was found by the District Court upon substantial evidence to have the same construction, mode of operation and result produced as the accused pumps and, consequently, if the claims of the patents in suit embrace the accused pump, they also include the structure shown in the 1913 Veronesi patent, Exhibit M, and the 1927 Veronesi patent, Exhibit N, and are consequently invalid.

Appellant's contention that the patents in suit disclose a new combination is directly contrary to the facts as found by the trial Court, and the facts shown by the record. The record discloses jet pumping systems including a jet and a centrifugal pump in which there is a dual discharge from the centrifugal pump, one from a low pressure stage and the other from a high pressure stage directed solely to the jet. That the insertion into this system of any other type of old and well-known centrifugal pump, (if the construction thereof is important) would not make a new combination, but, to the contrary, would be an obvious, old, exhausted combination which could be effected without the exercise of invention, as the trial Court found as a fact.

The District Court found that the claims of the patents in suit "are so broadly drawn" as to include virtually every possible system in which a multiple pressure discharge is supplied from a pump with

an ejector attached. This is a finding completely sustaining the pleaded, independent and separate defense that the claims are invalid under R. S. 4888. The appellant did not specify such a finding to be error and did not argue that the claims are sufficiently definite to comply with said statute, and consequently this defense is sufficient in itself regardless of the validity of the remaining defenses to sustain the Court's conclusion that the patents are invalid, rendering the question of the validity of the remaining of the defenses moot.

The District Court found as a fact that claim 13 of patent No. 2,424,285 (the latest issued of the two patents in suit) in substance is identical with the claims in patent No. 2,344,958 (the earliest issued of the two patents in suit) which do not specify that the discharge opening to service is valve free. This is a complete finding that the pleaded defense that patent No. 2,424,285 is invalid for double patenting independently of the remainder of the defenses. The appellant has not specified such a finding as error or attempts to overcome in its brief the finding of double patenting. This defense, being sufficient in itself independently of the remainder of the defenses to sustain the Court's conclusion that patent No. 2,424,285 is invalid, the remainder of the defenses become moot.

The appellant argues that there is conflict between the facts found by the trial Court. Such conflicts, if there are any, are arrived at by straining the

language of the trial Court in its opinion and comparing them with specific findings of fact separately stated, and such conflicts, if any, are of a trivial and unimportant character.

Appellant argues in its brief that appellees' obtaining a patent on the precise construction of their centrifugal pump is a basis for inference that the patents in suit are valid and embody invention. The Courts never have drawn any such an inference because such an inference is too far-fetched to be given serious consideration. In the matter of declaring a patent valid or invalid, the Court looks to the rights of the public to see if a part of the public domain has been carved out by the patent and, therefore, adversely affecting the rights of the public.

ARGUMENT.

THE FINDINGS OF THE DISTRICT COURT BEING FINDINGS OF FACT SHOULD NOT BE SET ASIDE SINCE THEY ARE NOT CLEARLY ERRONEOUS AND ARE SUPPORTED NOT ONLY BY SUBSTANTIAL EVIDENCE BUT BY THE OVERWHELMING WEIGHT OF THE EVIDENCE.

In support of this conviction we rely upon recent decisions of this Court:

“(3) We are of the view that the trial Court committed no error in its factual findings and that its determination and application of the law was and is correct.

(4) The question of whether or not a new and useful combination is the result of mere

mechanical skill, or of inventive faculty, is one of fact.

(5) What constitutes invention as distinguished from a mere aggregation, is a question of fact.

(6) Questions of invention and patent validity are questions of fact.

(7) Whether prior art patents or publications disclose or anticipate the subject matter of a patent in issue is determined as a question of fact.”

Faulkner v. Gibbs, 170 F. (2d) 34, at 37 (C.C.A. 9, 1948). (Rehearing denied 1948.)

“The court, by its above mentioned findings, determined two questions—the question of novelty and the question of invention. *Both were questions of fact.* *Ralph N. Brodie Co. v. Hydraulic Press Mfg. Co.*, 9 Cir., 151 F. 2d 91 [66 U.S.P.Q. 396]; *Maulsby v. Conzevoy*, 9 Cir., 161 F. 2d 165 [73 U.S.P.Q. 249]. *The findings are supported by substantial evidence, are not clearly erroneous and should not be disturbed. * * **”

Refrigeration Engineering, Inc. v. York Corporation, 78 U.S.P.Q. 315, at 317 (C.C.A. 9, 1948).

“* * * Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses * * *”

Federal Rules of Civil Procedure, Rule 52(a).

Only a portion of the evidence supporting the findings and conclusions of the District Court that the patent claims in issue are invalid can be presented herein. This portion of such evidence, it is submitted, is abundantly sufficient to establish that the findings and conclusions of invalidity are supported by substantial and overwhelming weight of evidence, and hence such findings and conclusions should not be disturbed.

APPELLANT'S CONTENTION THAT THIS COURT SHOULD GIVE DE NOVO CONSIDERATION TO THE EVIDENCE BECAUSE THE TRIAL COURT HELD THE PATENTS TOTALLY INVALID IN SPITE OF THE ISSUANCE THEREOF BY THE UNITED STATES PATENT OFFICE SHOULD BE REJECTED.

The appellant contends (appellant's brief, page 19) :

“Conflicting findings between the District Court and the Patent Office of the same prior art warrants *de novo* consideration thereof.”

If this contention is valid, then in every case in which a trial Court holds a patent invalid on the usual grounds of lack of invention, lack of patentability, ambiguity of the claims, and double patenting, this Court of Appeals would be warranted in giving *de novo* consideration to the evidence. This position is untenable. To support this contention, however, appellant assumes and builds false premises which are:

(a) that the patents in suit come before this Court with the presumption of validity;

(b) that the trial Court relied for invalidity and lack of invention on the same art considered by the Patent Office.

These premises are shown by the record to be without foundation. The Patent Office considered in connection with both patents in suit only the following prior patents of those before the trial Court:

Jacuzzi No. 2,150,799, Exhibit T.

Ensslin No. 1,494,595, Exhibit R.

Veronesi No. 260,417, Exhibit N.

Schmid No. 382,592, Exhibit V.

Hilliard No. 1,059,994, Exhibit AJ-5.

These were but a part of the prior art patents considered and relied upon by the District Court in finding lack of invention and invalidity of the patents in suit. The following prior art patents, which were considered by the District Court and relied upon by the District Court in finding lack of invention and invalidity, were not before the Patent Office or considered by it in passing upon the patents in suit:

Veronesi No. 139,161 (1913), Exhibit M, R. 545—specifically relied upon by the District Court in Finding of Fact 16, one of the findings showing lack of invention of the patents in suit.

Speck (German) No. 376,684, Exhibit U, R. 591—used by the District Court in Finding of Fact 17, one of the findings showing lack of invention of the patents in suit.

Sulzer No. 704,144, Exhibit O, R. 561—specifically relied upon to show lack of invention

of the patents in suit in Findings of Fact 12, 27 and 28.

Rateau No. 730,842, Exhibit P, R. 564—specifically relied upon to show lack of invention of the patents in suit in Findings of Fact 12, 27 and 28.

Stepanoff No. 2,248,312, Exhibit Q, R. 569—specifically relied upon to show lack of invention of the patents in suit in Findings of Fact 12, 27 and 28.

Jacuzzi No. 1,758,400, Exhibit S, R. 579—specifically relied upon in Finding of Fact 16, which is one of the findings showing lack of invention of the patents in suit.

Therefore, it is to be noted that the Patent Office overlooked a great portion of the real pertinent art and, therefore, under the authorities of this Circuit, the presumption of validity which attends the issuance of the patent by the Patent Office is overcome and the patents are before this Court without any presumption of validity.

In a Ninth Circuit case, *Metler v. Peabody Engineering Corp.*, 77 Fed. (2d) 56, 58, the rule controlling here is given as follows:

“The presumption of validity which attends the issuance of letters patent by the Patent Office is overcome in this case by the clear evidence of anticipation in the prior art which was not cited or considered by the Patent Office when

the application for appellant's patent was passed on."

To the same effect is the following:

France Mfg. Co. v. Jefferson Electric Co., 6 C.C.A., 106 Fed. (2d) 605:

"The usual presumption of validity arising from the granting of the patent in suit is weakened when the Patent Office did not have its attention directed to the most pertinent art."

McClintock v. Gleason et al., 9th C.C.A., 94 Fed. (2d) 115, 116:

"The strong presumption of validity arising from the granting of a patent is weakened when it appears that the patent is granted without reference to pertinent art."

O'Leary v. Liggett Drug Co., 150 Fed. (2d) 656:

"The issuance of a patent creates no presumption of validity sufficient to overcome a pertinent prior art reference which has not been considered in the Patent Office."

It is, therefore, clear that the District Court in addition to the prior art considered by the Patent Office considered entirely different and more pertinent art, and, therefore, the patents stand before this Court without any presumption of validity, and unless appellant can show that the findings of the trial Court are clearly erroneous or not supported by substantial evidence, such findings should not be disturbed on this appeal and the evidence should not be given *de novo* consideration by this Court.

THE PUMPS HERE IN ISSUE DID NOT SUPPLANT OR TAKE THE PLACE OF PRIOR PUMPS BUT WERE NO MORE THAN THE NORMAL ADVANCE IN DESIGN OF THE PRIOR PUMPS TO ACCOMMODATE THE GRADUALLY RECEDING WATER LEVEL AND THE CONSEQUENT DEEPENING OF WATER WELLS IN A FEW AREAS OF CALIFORNIA.

The history of water well pumps, as shown by this record, is that such pumps were gradually changed to keep pace with the gradual changing or lowering of the water table in certain areas of the state, and the consequent gradual deepening of the water wells. (Armstrong's testimony R. 218-219, Carpenter's testimony R. 267-268, Jacuzzi's testimony R. 136.)

At first all of the wells were relatively shallow and the pumps of the general type here under consideration, as shown by the record, were small single stage centrifugal pumps (see page 11, Exhibit 17) without a jet. Then, as wells in certain areas were required to be deeper, jets were added to these single stage pumps to accommodate the increased depth. Then, as the wells in some areas continued to be deepened, and larger quantities of water were desired, the more efficient two stage pumps came into being which provided a greater delivery of water and at a more efficient operation, and at a lower speed. These two stage pumps were adapted both to shallow wells not requiring a jet and the deeper wells which required a jet. Then, as wells deepened, the two stage jet pump systems were enlarged by adding more stages to them, and finally when the pressures to operate the jets in certain restricted areas (because of the depth of the water table) became greater than it was necessary for

household use, or for irrigation, the designers accommodated this change by taking the discharge for use off of the low pressure of the pump and used the high pressure merely to operate the jet.

In other words, it was a continuous application of engineering skill to adapt existing pumps to the progressively changing conditions. However, there is still and always has been a need and a wide field even for the older type single stage pumps as well as the intermediate developments for the reason that different areas have different requirements, and because different farms have different requirements for water. Therefore, the present method of taking off the low pressure discharge from a low pressure stage of the pump and delivering the highest pressure discharge solely to the jet (even if new, which it is not) is no more than a carrying forward of the earlier pumping system in which the irrigation water at very low pressure was taken off ahead of the first stage of the pump while water from the highest stage of the pump was delivered back to the jet. It merely carried forward this old idea to a field of deeper wells.

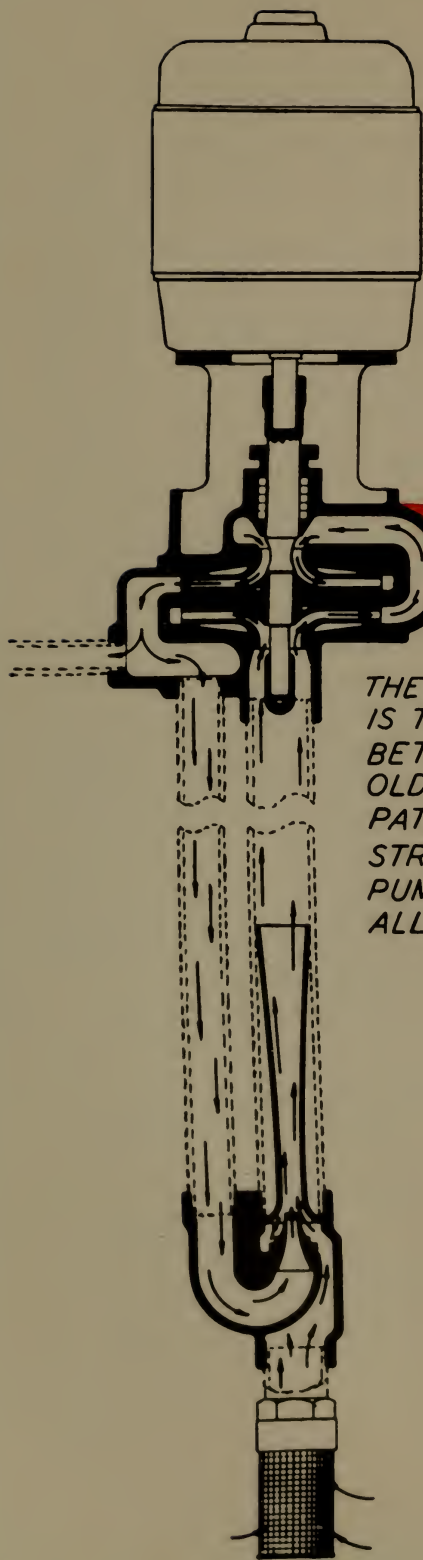
At most, the pumps with the dual discharge, such as shown in the patents, merely supplemented the older line of pumps and did not supplant them or render them obsolete.

THE APPELLEES' PUMPS ADVANCED STEP BY STEP
KEEPING PACE WITH FIELD DEMANDS.

As is evident from the record, appellees started with single stage pump—advanced to a jet—then a two stage pump with and without a jet; then a dual discharge pump, low pressure take-off ahead of the first centrifugal pump stage taking its pressure from the jet, and a high pressure take-off at the highest stage to the jet. All these pumps are still in the appellees' line as well as turbine pumps and others, so that all the various requirements of different localities as well as different conditions can be met.

When the water table receded in certain localities, it was the natural thing to add a pump to meet this new and special condition. The only thing that appellees did which is charged to infringe is the appellees' tapping a hole in the pump casing for a discharge at the first stage. This gave appellees a single pump housing which by a system of holes and connections could be adapted to a wide range of conditions needing any of the following range of pumps:

- a. shallow well pump without jet and single discharge;
- b. shallow well pump with jet and a single discharge pressure;
- c. deep well pump with jet and a single discharge;
- d. shallow well pump without jet with dual discharge pressure;



THE TAPPED OPENING IN RED
IS THE ONLY DIFFERENCE
BETWEEN DEFENDANTS
OLD (LONG PRIOR TO
PATENTS IN SUIT) PUMP
STRUCTURE AND THE
PUMP STRUCTURES HERE
ALLEGED TO INFRINGE

e. deep well pump with jet and dual discharge pressure.

All five meet widely varying conditions both as to well depths and pumping requirements.

What change was required? On the opposite page we illustrate what the record shows (in black) was appellees' prior pump. (R. 247-248.) The red colored addition was the only change made to change it from a non-accused pump to an accused one. Such change was the ordinary routine engineering change such as had been and always will be made from time to time to accommodate changing field conditions. Such slight, trivial changes are not inventions and should not be monopolized.

Certainly, the new pump for its special purpose is a good pump and does meet a new set of conditions and demands, but automobiles are likewise changed from year to year for the same reason but each such change therein is not considered invention.

In *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U.S. 84, 86 L. Ed. 58, the Court said:

“We may concede that the functions performed by Mead's combination were new and useful. But that does not necessarily make the device patentable. Under the statute 35 U.S.C. sec. 31, R.S. 4886, the device must not only be ‘new and useful’, it must be ‘invention’ or ‘discovery’. *Thompson v. Boisselier*, 114 U.S. 1; 29 L. Ed. 76. * * *”

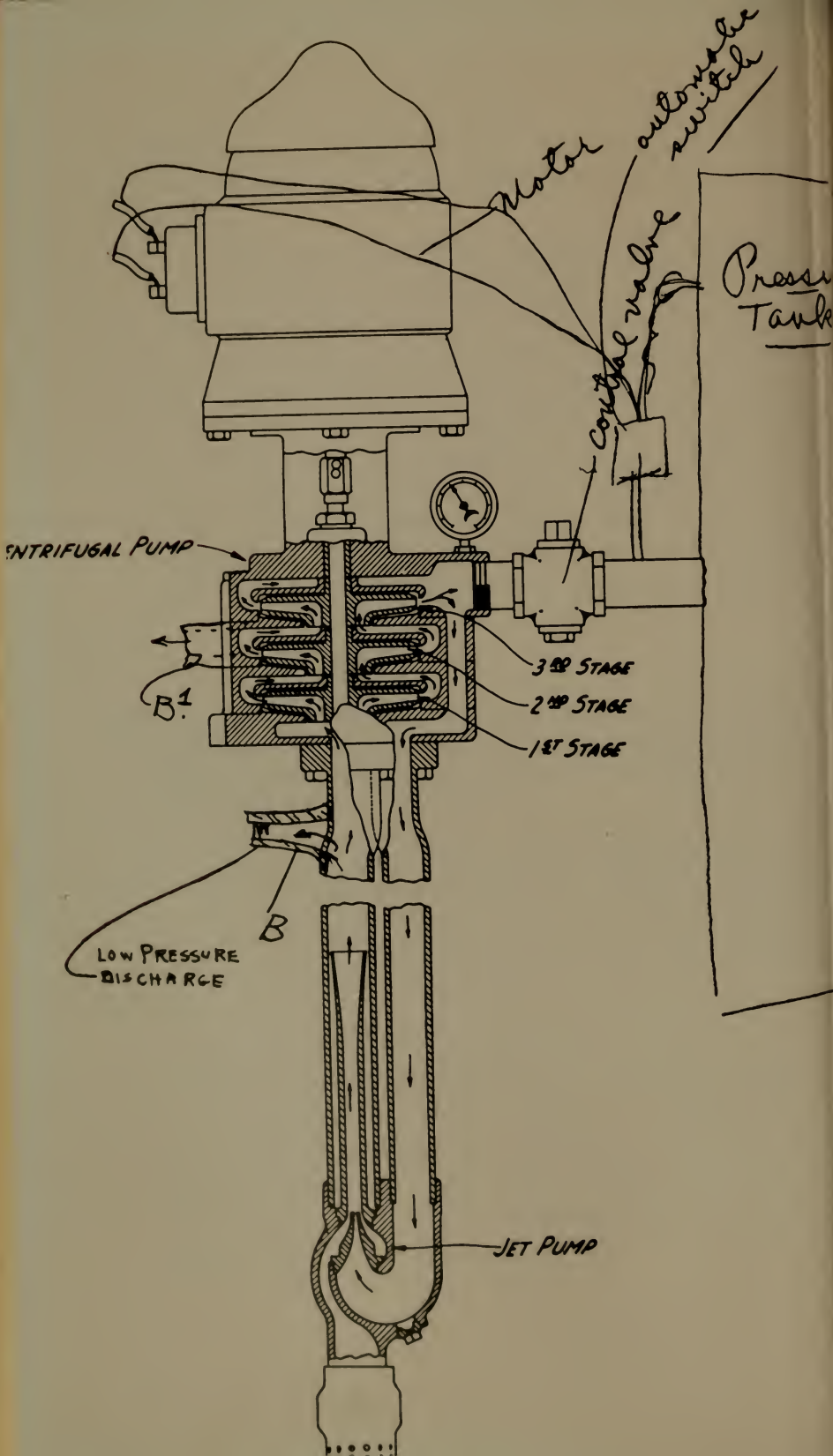
This Court of Appeals held in *Wilson-Western Sporting Goods Co. v. Barnhart*, 81 Fed. (2d) 108, as follows:

“ ‘The process of development in manufactures creates a constant demand for new appliances, which the skill of ordinary headworkmen and engineers is generally adequate to devise, and which, indeed, are the natural and proper outgrowth of such development. * * * To grant a single party a monopoly of every slight advance made, except where the exercise of invention somewhat above ordinary mechanical or engineering skill is distinctly shown, is unjust in principle and injurious in its consequences.’ ”

THE STEP WHICH PATENTEES CLAIMED TO HAVE TAKEN AND WHICH IS CONTENDED TO BE INVENTION WAS TO CHANGE PRIOR WATER SYSTEMS ONLY IN DEGREE AND NOT IN KIND OR CHARACTER.

The appellant in its brief (as will be pointed out later herein) hides the actual step claimed to have been taken by the patentees by using many words. Stripped of all non-essentials that step was simply moving

a. the low pressure discharge from a point in the water system just ahead of the first stage of the centrifugal pump (where it receives the water pressure from the jet pump) to a point on the centrifugal pump casing where it also receives the water pressure from the first or second stage of the centrifugal pump, or



b. moving the discharge to use from the highest stage to next lower stage.

Simply illustrated ("a" above), one admittedly old commercial system is shown in Exhibit A (reproduced opposite) (R. 535) with the low pressure discharge indicated thereon at B. The simple step taken by the patentees was to move that discharge to the point indicated thereon by B1. The only result actually achieved was that the pressure of the water emerging from discharge at B1 was greater than that emerging from discharge at B. This is merely a change in degree and did not effect either

- a. a new mode of operation;
- b. a new result different in kind or character;
- c. an improved unforeseeable result unobvious to those skilled in the art.

These are the elements which are essential in order to find patentable invention.

Dr. Folsom testified that such change merely resulted in a difference in degree not in kind as follows (R. 294):

"Now, Dr. Folsom, if you move the discharge B on Exhibit A from the suction line and put it where I am dotting it on the second stage and labeling it B-1, would you say that moving it from the suction line to that second stage would impart to that system a new or different mode of operation than it had when the discharge B was on the suction line?"

A. The position of the low pressure discharge does not change the mode of operation of the pumping system.”

He also testified that the mode of operation of the old system with the discharge at B was identical with the mode of operation of the system when the discharge was at B-1 (except as to the degree of discharge pressure) as follows (R. 294-295):

“Q. Would the difference in result obtained by moving the discharge B from the suction line to the second stage as marked at B-1, be one of difference in kind or a difference in degree?

A. Well, there is one that is difference in degree, because the location of the particular output or the particular location of that nozzle depends upon the requirements needed by the particular installation.

Q. And that difference would be one in the discharge pressure?

A. That's right.

Q. And that would be the only difference, Doctor, or not?

A. Right. The mode of operation is the same, the discharge takeoff is located from engineering considerations to give you the required pressure for the installation considered.”

The fact that the only difference between prior pumps of the character here under discussion and the patented pumps is merely one of degree of discharge pressure is emphasized in the plaintiff's own catalog (Exhibit 11) of its commercial pumps.

To illustrate the second condition (“b” above) on the opposite page we have reproduced the illustration

THE ONLY CHANGE OR DIFFERENCE EFFECTED BY THE ALLEGED INVENTIONS IS MOVING THE DISCHARGE OUTLET FROM THE LAST STAGE (HERE) TO THE NEXT TO THE LAST STAGE (HERE) (RESULT! ONLY A LOWER DISCHARGE PRESSURE) THIS IS NOT INVENTION EVEN IF NOVEL.

JACU

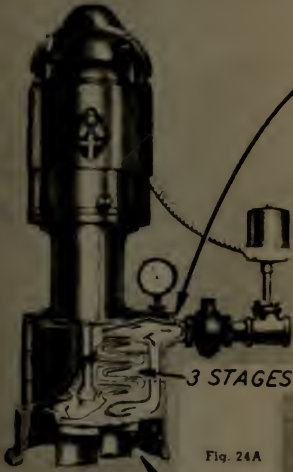


Fig. 24A

PLAINTIFF'S 1939 COMMERCIAL PUMP PART OF THE PRIOR ART EX.T.

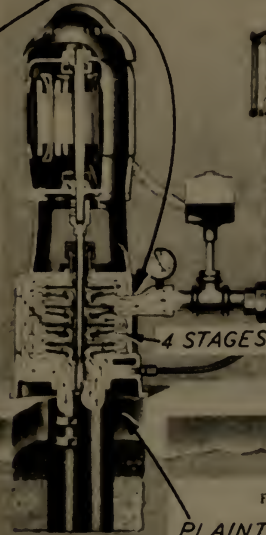


Fig. 34A

PLAINTIFF'S COMMERCIAL PUMP EMBODYING THE ALLEGED INVENTIONS OF THE PATENTS IN SUIT.



REPRODUCED FROM PLAINTIFF'S CATALOG EXHIBIT #11 PAGES 24 & 34



24a from page 24 of appellant's own catalog (Exhibit 11), showing the older type (part of the prior art as shown in Jacuzzi patent No. 2,150,799, Exhibit T, R. 584), and alongside we have reproduced Figure 34a which is the illustration on page 34 of the same catalog (Exhibit 11) which embodies the alleged invention of the patents in suit.

Notice that *the only difference** between the two pumping structures is the fact that in the earlier pump structure (Figure 24a) the take-off for use is from the last stage, at which point the water is divided, part of it going to the discharge for use and the remainder going back to the jet. Then, refer to Figure 34a, which is the patented structure, and notice that the arrangement is precisely the same except that the discharge instead of at the last stage is from the next to the last stage, so that the take-off pressure is a little lower than the discharge of water for use from the pump shown in Figure 24a. Thus, the testimony and the evidence to the effect that the only difference between the patented pumps and those of the prior art is merely one of degree, and that is only the degree of discharge pressure, is amply sustained.

Appellant's attempt to rebut such evidence is illogical and insufficient.

In attempting to overcome such a logical conclusion, this appellant's witnesses simply stated, such

*For the control valve in Figure 24a there is substituted in Figure 34a a mechanical water divider on the next to the last impeller. (Appellees do not use such a divider.)

change gave it a new mode of operation but gave no explanation to overcome the obvious correctness of Dr. Folsom's testimony that the change was merely one of degree. Mr. Jacuzzi, who attempted to contradict Dr. Folsom's testimony, testified simply that when you change the discharge from B to B1 (Exhibit A), you gave the system a new mode of operation. However, his idea of "new mode of operation" is that any slight change creates a new mode of operation. This he clearly demonstrated when *he testified that changing the low pressure discharge from one early stage of the centrifugal pump to another gave the system a "new mode of operation"*. That testimony appears at R. 163 and 164 and is as follows:

"Q. When you change the low-pressure discharge from the second stage to the third stage, you do not change your mode of operation, do you?"

A. Yes."

(At this point Mr. Jacuzzi by clear inference corroborates Dr. Folsom that the only change is one of degree (of pressure). They merely disagreed as to whether a mere change in pressure is or is not a "new mode of operation".)

"Q. That is still a different mode of operation, is that correct?"

A. That changes the mode of operation, because instead of taking it out at this point, we are bringing it up higher.

Q. *The only difference is that you get a different pressure of the low pressure discharge?*

A. *You mean you are getting a different pressure once you are bringing it up here on an upper stage.*

Q. *That is right, you get a higher pressure on the upper one?*

A. *Higher pressure.*

Q. *So you can select the pressure of the low-pressure discharge at any one from the first to the last stage?*

A. *Yes.*

Q. *And when you make those changes, you do not change the mode of operation of the system, do you?*

A. *Yes.*

Q. *You do. Each one is a change in mode of operation of the system?*

A. *Yes."*

This testimony shows the utter worthlessness of Jacuzzi's testimony in rebutting Dr. Folsom's testimony that whether the low pressure discharge was at B or B1, the mode of operation was the same with the change in result merely one of different pressure.

Therefore, we submit that the patented water systems do not have a new mode of operation nor do they produce a result different from the prior system of Exhibit A except to a matter of degree. In such state of facts the patents are invalid as lacking in patentable invention.

A change merely in degree is not patentable and this Court of Appeals has so ruled many times.

See *Wilson-Western Sporting Goods Co. v. Barnhart*, 81 Fed. (2d) 108, wherein the Court stated:

“ ‘But a mere carrying forward or new or more extended application of the original thought, a change only in form, proportions, or degree, the substitution of equivalents, doing substantially the same thing in the same way by substantially the same means with better results is not such invention as will sustain a patent.’ ”

* * * * *

“ ‘The process of development in manufactures creates a constant demand for new appliances, which the skill of ordinary head-workmen and engineers is generally adequate to devise, and which, indeed, are the natural and proper outgrowth of such development. Each step forward prepares the way for the next, and each is usually taken by spontaneous trials and attempts in a hundred different places. To grant a single party a monopoly of every slight advance made, except where the exercise of invention somewhat above ordinary mechanical or engineering skill is distinctly shown, is unjust in principle and injurious in its consequences.

“ ‘* * * It was never the object of those laws to grant a monopoly for every trifling device, every shadow of a shade of an idea, which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufactures. Such an indiscriminate creation of exclusive privileges tends rather to obstruct than to stimulate invention. It creates a class of speculative schemers who make it their business to watch the advancing wave of improvement, and gather its foam in the form of patented monopolies, which enable them to lay a heavy tax upon the industry of the country, without contributing

anything to the real advancement of the art. It embarrasses the honest pursuit of business with fears and apprehensions of concealed liens and unknown liabilities to lawsuits and vexatious accountings for profits made in good faith.' ”

See also the cases therein cited.

CENTRIFUGAL PUMPS WITH SELECTIVE OR DUAL DISCHARGE (ONE AT A LOWER STAGE OF THE PUMP THAN THE OTHER) ARE ADMITTEDLY OLD AND THE ADDITION OF A JET TO AN OLD CENTRIFUGAL PUMP AS TAUGHT BY PRIOR WATER SYSTEMS IS NOT INVENTION, BUT INVOLVED AT MOST NO MORE THAN MECHANICAL SKILL.

Particularly is the above demonstrated when it was admittedly old to provide a water system such as here at issue with a centrifugal pump and a jet. This is one of the old water systems which appellant's own witness Mr. Jacuzzi testified was old and well known (commencing at R. 154) and is diagrammed in the drawing. (Appellees' Exhibit A reproduced here opposite page 17.) That system, as Mr. Jacuzzi testified (R. 155-157), was built and used long prior to 1940.

Appellant has attempted to create the impression that the patents in suit disclosed the first multi-stage pumps with selective or dual discharges. This is far from the true facts for, as a matter of fact, such pumps have been in existence for many, many years prior to the patents in suit as the Court so found in Finding 12. (R. 80.)

Dr. Folsom, in testifying with respect to the prior art, in substance testified, and his testimony stands uncontradicted, that the Sulzer patent, Exhibit O (R. 561), discloses a pump having four stages with selective take-offs from any one of the four stages or a combination thereof. (R. 286-287.)

The Rateau patent, Exhibit P (R. 564), discloses a two-stage pump having a discharge from both stages. (R. 287-288.)

The Stepanoff patent, Exhibit Q (R. 569), discloses a multi-stage pump having one discharge from the fourth stage and a second discharge from the ninth stage, so that in normal operation fluid can be taken off at two different pressures. (R. 291.)

Dr. Folsom testified at length (at R. 300) that the 1913 Italian patent to Veronesi disclosed a multi-stage pump in a jet pump system having a mode of operation identical to those here involved, which discharges water at two different stages and at two different pressures. Also (at R. 304) he discussed the 1927 Italian patent to Veronesi, stating that this patent disclosed a multi-stage pump having discharges from two different stages, the one of higher pressure discharging solely to the jet, the lower pressure for use.

Automatic water systems including a pressure tank, an automatic pressure switch, a multi-stage centrifugal pump and a jet are admittedly old.* This being

*1913 Veronesi patent, Exhibit M. (R. 545.)

1923 Speck patent, Exhibit U. (R. 591.)

Jaeuzzi system, Exhibit A. (R. 535.)

1927 Veronesi patent, Exhibit N. (R. 552.)

true, how then can it possibly be invention to substitute an old multi-stage centrifugal pump having such a dual discharge for the multi-stage centrifugal pump of an old well pumping system with a single discharge? Obviously, no more than ordinary mechanical skill was involved in making such change. Therefore, no patentable invention was involved and the Court so found.**

In *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U.S. 84, 62 S. Ct. 37 (1941), the Supreme Court said:

“* * * More must be done than to utilize the skill of the art in bringing old tools into new combinations. (Citing cases.)”

* * * * *

“We may concede that the functions performed by Mead’s combination were new and useful. But that does not necessarily make the device patentable. Under the statute, 35 U.S.C. § 31, 35 U.S.C.A. § 31, R.S. §4886, the device must not only be ‘new and useful’, it must also be an ‘invention’ or ‘discovery’. *Thompson v. Boisselier*, 114 U.S. 1, 11, 5 S. Ct. 1042, 1047, 29 L. Ed. 76. Since *Hotchkiss v. Greenwood*, 11 How. 248, 267, 13 L. Ed. 683, decided in 1851, it has been recognized that if an improvement is to obtain the privileged position of a patent more ingenuity must be in-

**Finding 46 (R. 91): “The pumping systems claimed in the claims of patent No. 2,424,285 would be substantially duplicated without invention merely by connecting an injector to one of the high-pressure discharge connections of the old and well known multi-discharge centrifugal pumps such as shown in patents Nos. 704,144, 730,842, 2,248,312 and 1,494,595, Defendants’ Exhibits Nos. O, P, Q and R.”

volved than the work of a mechanic skilled in the art. (Citing cases.)”

This Court of Appeals followed this rule in *Bailey v. Sears, Roebuck & Co.*, 115 Fed. (2d) 904:

“We conclude that the trial court was correct in holding that a mechanic skilled in the art of radio condenser and cabinet construction, given the problem of measuring or determining the position of the rotors of the condenser by means of a clock faced dial, with two hands, one faster and one slower, already used in that art, would not require or exercise inventive genius in designing the patented device. Hence, such a mechanic cannot claim a patent monopoly and exclude other skilled mechanics from using the same or its equivalent devices. Hence, we hold that there was no invention in the patent under consideration.”

See also

Wirebounds Patents Co. v. H. R. Gibbons Box Co. (C.C.A. 7-1928), 25 Fed. (2d) 363, 365.

APPELLANT IN ITS ATTEMPT TO BOLSTER ITS INVALID PATENTS ATTEMPTS TO CLOTHE THEM WITH FUNCTIONAL ADVANTAGES AND FEATURES WHICH THE RECORD DISCLOSES AND THE DISTRICT COURT FOUND TO BE OLD AND PRESENT IN PRIOR PUMPS OF THE SAME CHARACTER.

Appellant, in its brief, pages 6 to 12 inclusive, attributes to its patented pumps functional advantages and features (all disclosed in the record to be old and so found by the District Court) as if they appeared for the first time in the patented pumps.

All of the functional advantages and features claimed for the patented pumps by appellant were old in prior art and commercial pumps, admittedly so in most instances by appellant's own witnesses. Those not so admitted to be old by appellant's own witnesses were shown to be old by the record and so found by the District Court. For example, in appellant's brief, pages 10 and 11, there appears:

“Therefore, *a mere opening of the spigot at the end of the irrigation line* during quiescent periods of the pump unit will *automatically* bring about the starting of the pump unit, and it is not necessary to walk all the way back to the pump unit to throw a switch or manually operate any control for this purpose (R. 115).”

The above feature in pumps was not only shown to be old by the prior art, but was admitted by appellant's witness Jacuzzi in his testimony to be old.* On this point Mr. Jacuzzi testified (commencing R. 156) as to prior systems which were used by appellant, in which prior systems a motor, pressure-operated switch and pressure tank were used and when the spigot in the discharge line was opened at some distant point, the motor would immediately commence to operate. In fact, he attributed this identical operation to the prior art pump wherein a low pressure discharge was taken off of the suction line just prior to the first stage, and the discharge to the jet was from a high pressure stage (R. 157-159). Consequently, appellant's above quoted statement is mis-

*Found to be old by the District Court in Finding 40 (R. 89).

leading if it conveys that the patented construction was the first to provide such mode of operation.

Also, in appellant's brief, pages 11 and 12, appears the following:

"The invention of combination C pertains to an *injector* type system which is self-balancing and consequently *inherently stable*."

"Complete elimination of control valves from the system and the cost thereof (R. 136, 458).

"The self-balancing feature has its origin in the *discovery* by the patentees that, in a pump system employing the *injector* principle, if the injector assembly were supplied from a stage of the pump unit *other* than those from which the service discharge is taken and flow of water to the injector were *favored* over flow to service, the pump unit will automatically meet the changing requirements of the injector assembly with changes in conditions within the well, and thus eliminate the principal cause of a pump system losing its prime and becoming inoperative."

Appellant, in its brief, attempts to clothe "inherently stable," "self-balancing" and "no need for a control valve" with an aura of mystery and complication and says, in effect, it was a discovery of the patentees. Nothing is further from the fact. "Inherently stable" and "self-balancing" in pump parlance merely means a multi-stage centrifugal pump design in which a full supply of water is always available to the last or highest impeller stage of the pump, so that impeller stage will not be starved but will deliver the full quantity of water demanded of it.

When such provision in the centrifugal pump is made and the last impeller stage is connected to a jet or other medium to be supplied, the jet requirements of water will always be fulfilled simply because a full supply of water is always available to the last stage of the centrifugal pump to pump such water to the jet as the latter requires.

The patents in suit accomplish this "inherent stability" and "self-balancing" by *mechanically* dividing the water at the lower stage of discharge in a dual pressure pump. This *mechanically* insures that a measured full supply of water is delivered to the last stage, leaving the overage to discharge through the lower stage discharge. Without such mechanical division (because of the vertically stacked arrangement of the patented pumps), a restricting control valve would have to be placed on the intermediate discharge to build up a resistance to the discharge sufficient to insure delivery of a full measure of water to the last pump stage.* Thus, "mechanical division of the water" in the patents is substituted for a control valve.

The reason that a control valve or such mechanical division is necessary in the centrifugal pump of the

*The Court's attention is called to the fact that in the patent in suit '285 there is a control valve 50 discharging to the tank 58 from the stage of highest pressure. The reason that this control valve is necessary at that point is to restrict or back pressure the flow so that the water will be divided and part of it pumped back to the jet through the pipe 23. There is no way of mechanically separating the water at that point in that patent, so a control valve must be used due to the peculiar design of the pump itself.

patents is that the last stage is at an elevation higher than the intermediate stage so that the water has to travel uphill to it and cannot keep the last stage submerged by gravity.

This is peculiar only to the arrangement of the impellers or stages stacked on end with the highest stage impeller uppermost. If the same pump were disposed horizontally, no such mechanical division and no control valve would be necessary, as will be explained further herein, because such "inherent stability" and "self-balancing" and lack of necessity of a control valve is inherent in horizontally disposed multi-stage centrifugal pumps with dual discharges.

This "inherent stability" and "self-balancing" by insuring a full supply of water to the last stage without the use of a control valve in a multi-stage centrifugal pump with a dual discharge is old and well known and has long been accomplished in connection with such pumps. It was accomplished in prior dual multi-stage centrifugal pumps as well as in the accused multi-stage centrifugal pumps by arranging the low pressure pump discharge and the last stage impeller of the pump in such relative positions that the latter is always submerged in the water discharged by the preceding stage impeller by gravity, so that such last stage impellers get supplied with water first, and what is left over goes through the low pressure discharge—exactly the same end result as is accomplished by the patented pumps.*

*The District Court so found: see Findings of Fact Nos. 7, 8 and 11 (R. 78, 79 and 80).

Obviously, in this circumstance there is no need for a control valve because the design of the pump itself takes care of the "self-balancing" by insuring always a constant and full supply of water from the intermediate stage to the last stage.

Dr. Folsom in his testimony fully explains this, and *his testimony in this regard is the only testimony on the point and should be accepted as the fact.* Dr. Folsom first testified (R. 286) that the Sulzer patent (Exhibit O) discloses a multi-stage centrifugal pump with selective or dual discharges. At R. 288 Dr. Folsom testified that the Rateau patent (Exhibit P) likewise discloses a multi-stage centrifugal pump having a high pressure discharge from the last stage and a low pressure discharge from an intermediate stage. Dr. Folsom then went on to testify as to the reasons why and how, in these prior patents, the last stage is always kept completely fed with water despite the low pressure discharge, thus keeping the pump "self-balancing" and eliminating the need for a restricting type of control valve. He also testified that the manner in which this was accomplished in these prior dual discharge multi-stage centrifugal pumps was exactly the same as that used by the appellees in the accused pump to accomplish the same purpose. This testimony appears at R. 288 and R. 289 as follows:

"Q. What would be the condition of the inlet opening or eye of the second stage when the pump is in operation?

A. Due to the arrangement of the discharge valve, the eye of the second stage would be maintained submerged in water at all times.

Q. What effect, if any, would that have on the operation of the second stage, as far as delivering water to it?

A. In order to deliver water from the second stage, the inlet must be submerged.

Q. That is from the second stage. Is that condition of submergence and delivery of water to the second stage the same or unlike the condition shown in the pump in Exhibit 5 as far as the second stage is concerned?

A. It is alike.

Q. In other words, the second stage in the Rateau patent and the second stage in the Berkeley pump device shown in Exhibit 5 are both fed because they are maintained submerged during the operation of the pump, is that correct or incorrect?

A. That is correct."

The Court's attention is directed to the fact that although in the accused pumps the stages are stacked vertically, the discharge of the lowest stage is at the top of the stack so that water from the lowest pressure stage naturally maintains the highest pressure stage submerged, and it must, by the simple law of physics, be maintained submerged before any water can be delivered through the low pressure discharge at the highest elevation. This, as Dr. Folsom explained, is the same in operating principle as the prior Sulzer, Rateau and other dual discharge multi-stage centrifugal pumps. His testimony appears at R. 326 as follows:

"Mr. Mellin. Q. Now, with reference to Exhibit 5, Doctor, illustrating one of the defendant's

pumps, is it ever possible to stall the pump because too much water is drawn off of the low pressure?

A. You mean by stalling the pump, getting a condition where it will not pump water?

Q. That's right.

A. In the arrangement shown in Exhibit 5, no.

Q. And is it or is it not the reason for that, the submerged condition of the inlet eye of the second stage?

A. That is correct. If the inlet eye is submerged in the water, due to the gravitational effect inside the chamber."

Therefore, clearly there is no novelty or invention or any discovery by the patentees of the patents in suit that one can eliminate a control valve from a low pressure discharge of a centrifugal pump and make the same "inherently stable" and "self-balancing" by the provision of some medium for insuring a constant delivery of a full amount of water to the last or highest stage of the pump.*

Appellees' structure does not use any such positive water dividing means as shown in this patent but follows the teachings of the prior art in this regard, as pointed out just before herein.

Also in appellant's brief, page 10, the following is found:

*The Court found in Finding 7 (R. 78) that the absence of control valves in the system is unimportant, and in Finding 8 (R. 79) that the means shown in the patents in suit for positively dividing the water so as to eliminate the necessity of a control valve was old in prior United States patent No. 2,150,799, Defendants' Exhibit T (R. 584).

“This, the patentees of patent 285 accomplished through not only recognizing but taking advantage of the phenomenon that during *quiescent* periods of the pump unit in a conventional type *pressure* system, the tank pressure will equalize or spread throughout those portions of the pressure system which happen to be in open communication with the pressure tank.”

This characteristic of the pumping system of the patents is common to all pressure pumping systems heretofore used, and is not new in this particular system. “Equalization of pressure” or “automatic equalization” or “inherent equalization of pressure” in a water system has been an attribute of automatic water systems of this type for many, many years prior to the patents in suit. Mr. Carpenter so testified (without contradiction) at R. 357 as follows:

“A. In jet pipe pressure systems it is necessary that water equalize when they stop because it must be filled with water clear down to the foot valve.

Q. So that in all systems the whole system is full of water, isn't it?

A. Yes.

Q. And when you draw water from the system, if there is a storage tank, it equalizes back into the pump?

A. Yes.

Q. And when the pressure drops below the setting of the automatic switch, the pump commences to operate?

A. That is right.

Q. That is an inherent condition in pressure systems for how long, to your knowledge?

A. All centrifugal systems for as long as I can remember. To make a distinction, plunger pumps that do not need to be primed—

Q. I am talking about jet pipes, you understand, centrifugal pumps.

A. Jet pipe pumps have always equalized pressure.

Q. How long have you known of such systems?

A. Since 1925."

THE PUMPING SYSTEM SHOWN IN VERONESI 1913 PATENT, APPELLEES' EXHIBIT M (WHICH WAS NOT BEFORE THE PATENT OFFICE WHEN THEY CONSIDERED THE PATENTS IN SUIT), COMPLETELY NULLIFIES ANY CLAIM OF EITHER NOVELTY OR INVENTION IN THE PATENTS IN SUIT.

The Veronesi 1913 Patent (Exhibit M) was properly admitted in evidence.

Appellant in its brief, contends that the Veronesi Patent of 1913, No. 139,161 (Exhibit M) (R. 545) cannot be taken into account by either the trial Court or this Court because it was not pleaded in the answer and appellant was not given notice thereof, in accordance with 35 U.S.C.A., Section 69. This theory is directly contrary to the recent ruling by the Court of Appeals, Ninth Circuit, in the case of *Crowell v. Baker Oil Tools*, 153 Fed. (2d) 973. In passing upon the precise question here involved that Court held that 35 U.S.C.A., Section 69, was superseded by the *Federal Rules of Civil Procedure*. The Court there stated:

“* * * Therefore, it is unnecessary at this juncture to examine with technical nicety the allegations of the pleadings concerning these prior patents. However, *it should be noted that the nature of the pleadings is now controlled by the new Federal Rules governing civil procedure in the district courts of the United States and not by § 69 of 35 U.S.C.A. (Patents), first enacted in 1870, 16 Stat. 208, U.S.R.S. § 4920.*” (Emphasis ours.)

This case is the last expression on the subject by the Court of Appeals, Ninth Circuit, and we believe the same to be the controlling authority.

Even if this Court holds that the contested patent and publications cannot be used as an *anticipating* reference, there is no doubt whatever but what it can be introduced to show the state of the art. *Oswell v. Bloomfield*, 113 Fed. (2d) 377; *Minnesota Mining and Manufacturing Co. v. Industrial Tape Corporation*, 168 Fed. (2d) 7 (Cert. denied).

The only differences between the Veronesi 1913 Patent (Exhibit M) and the pumping systems under consideration are negligible.

With reference to the Italian patent, Exhibit M, which appears at R. 545, the Court found (R. 82):

“16. Prior art Italian patent No. 139,161, Defendants’ Exhibit M, discloses a multi-stage centrifugal pump with sets of impellers in parallel and an injector. The intake water is divided as it enters the pump, part going to one set of impellers and discharged for use at low pressure,

the remainder going to the second set of impellers and discharged under a higher pressure solely to supply the injector.”

In other words, this patent, except for the fact that the impellers are in parallel and not in series, has precisely the same mode of operation as the accused pump and produces the exact same result as the pumps as claimed in the patents in suit.

The only testimony as to the exact similarity between the mode of operation and obtained results of the pumping system disclosed in this Veronesi patent and the pumping systems under consideration is the testimony of Dr. Folsom. This testimony was completely uncontradicted and consequently should be accepted as fact in that Dr. Folsom is eminently well qualified to testify on the point and is of unimpeachable character.

Dr. Folsom testified (R. 303) that except for minor structural details of the centrifugal pump, the *pumping system of that patent (Exhibit M) and the accused appellees' pump (Exhibit 5) are the same.* The testimony is as follows (R. 303):

“Q. Thank you, Doctor. Now, Doctor, disregarding the fact that the water is divided between the high pressure and the low pressure portions of the pump in the Italian patent, M, is there any substantial difference in the mode of operation between the pumping system shown in that Italian patent and the mode of operation in the Berkeley pump (the accused pump) shown in Exhibit 5?

A. May I have that question again?

(Record read.)

A. Neglecting the details of the arrangement of the centrifugal pump, the pump system is the same.”

Dr. Folsom had already testified that the differences in the centrifugal pump of the 1913 patent, Exhibit M, and the type used in the accused device were differences merely of design and of no operational importance in the system, and did not change its mode of operation nor the result obtained. In other words, the type of pump used was up to the taste and selection of the engineer. Both constructions of centrifugal pumps are equally efficient (R. 303):

“Q. Does that Italian patent disclose to you an operative pump structure system?

A. Yes.

Q. And, Doctor, what about the efficiency of a pump of that character, where you are dividing it? Is it greater or less than if you had them in series, such as the Berkeley pump, No. 5, that you have alongside of it?

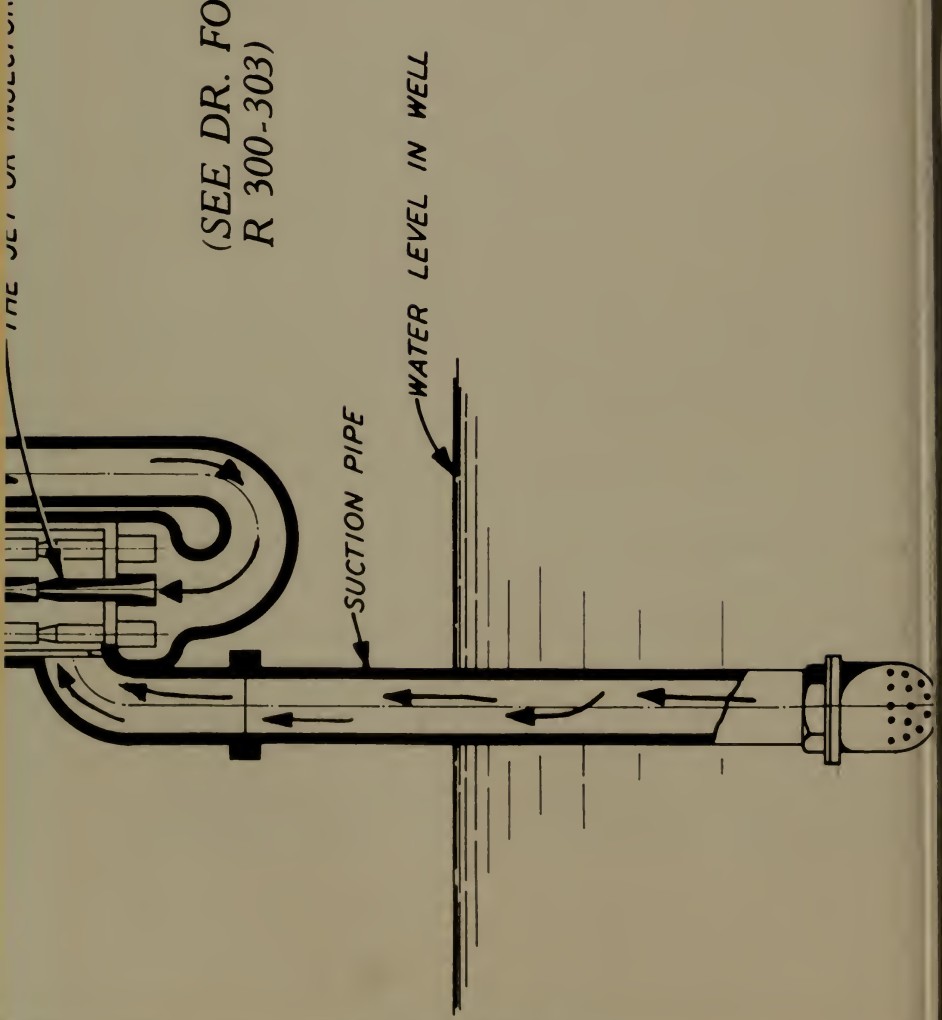
A. The efficiency is in the same order of magnitude. It depends more on the proportioning, the specific speed and other engineering features of the particular design is a consideration.

Q. In other words, that would be a matter of engineering skill, the skill of an engineer?

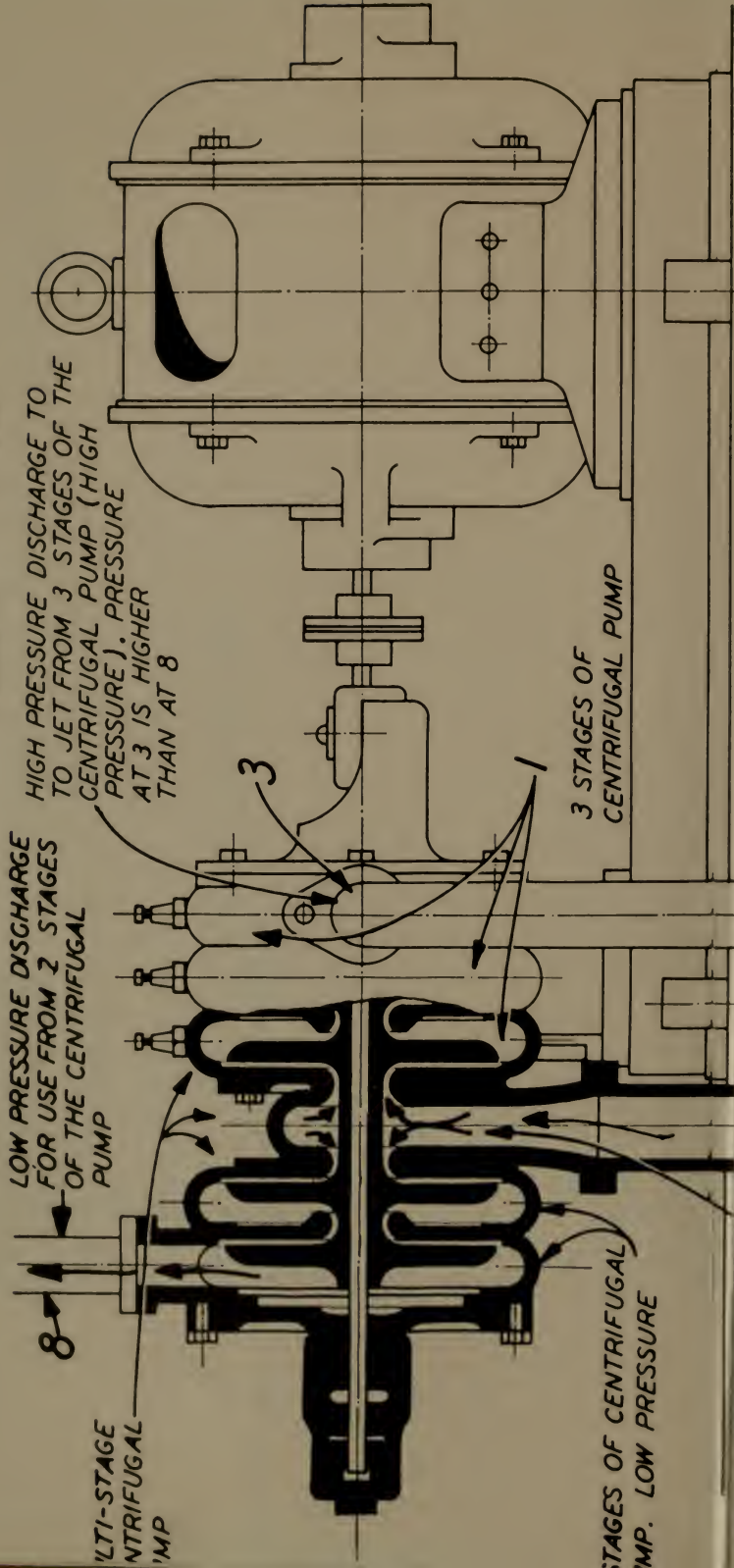
A. Right.”

To enable the Court to graphically follow Dr. Folsom's testimony, we have illustrated the sectional

(SEE DR. FOLSOM'S TESTIMONY
R 300-303)



1913 VERONESI PATENT (EX. M.)



LOW PRESSURE DISCHARGE FOR USE FROM 2 STAGES OF THE CENTRIFUGAL PUMP

HIGH PRESSURE DISCHARGE TO JET FROM 3 STAGES OF THE CENTRIFUGAL PUMP (HIGH PRESSURE). PRESSURE AT 3 IS HIGHER THAN AT 8

MULTI-STAGE CENTRIFUGAL PUMP

STAGES OF CENTRIFUGAL PUMP. LOW PRESSURE

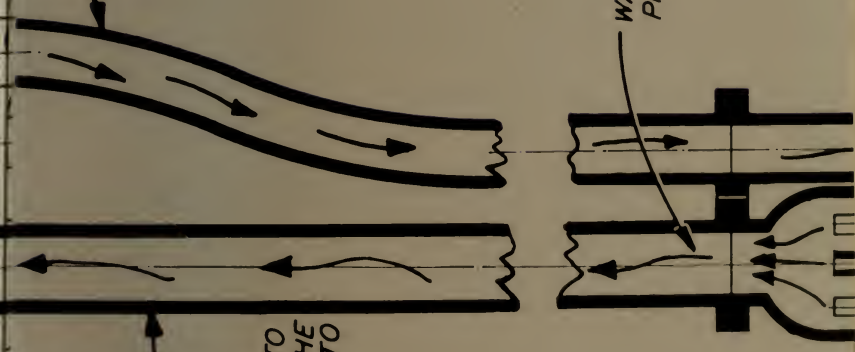
3 STAGES OF CENTRIFUGAL PUMP

3 STAGES OF CENTRIFUGAL PUMP

WATER IS DISCHARGED DOWN THIS PIPE
TO JET

WATER FORCED BY THE JET UP THE SUCTION
PIPE UNDER JET PRESSURE

2
WATER FROM SUCTION PIPE
DIVIDED - PART GOING INTO
THE 2 STAGE PORTION OF THE
JUMP AND PART GOING INTO
THE 3 STAGE PORTION OF
THE PUMP



view of the drawing of Veronesi 1913 patent (Exhibit M) opposite this page and have applied the substance of Dr. Folsom's testimony thereon (R. 299-306).

From Dr. Folsom's testimony the only difference between appellees' accused pumping systems and that of Veronesi 1913 patent (Exhibit M) is the design of the centrifugal pump in the system which makes no difference in the mode of operation or efficiency in the system, as Dr. Folsom testified as above.

The appellees' centrifugal pump is just as different from appellant's as it is from the prior patent being in upside down arrangement with a reverse fluid flow. Consequently appellees' pump system having the same mode of operation as Veronesi 1913 patent (Exhibit M), if it also has the same mode of operation as the systems of the patents in suit, then the latter are the full equivalent of the Veronesi system of Exhibit M, and are anticipated thereby and clearly invalid.

Dr. Folsom's testimony was not contradicted by any witness nor did appellant offer any evidence whatsoever on said Exhibit M, so the record is bare of any evidence to the contrary.

For the Court's convenience we below set out a side by side comparison of the Veronesi 1913 disclosure (Exhibit M) and the accused pump.

Veronesi 1913 Disclosure.

It includes :

- a. a multi-stage centrifugal pump
- b. having a dual discharge
- c. a low pressure discharge for use
- d. a high pressure discharge solely connected to a jet to operate the same
- e. the jet forcing water from deep well into the suction of the centrifugal pump
- f. the water entering the suction of the pump being divided by the inherent characteristics of the pump casing design, and part discharging through low pressure discharge for use and part discharging through high pressure discharge to operate the jet

Appellees' Accused Pump.

It includes :

- a. a multi-stage centrifugal pump
- b. having a dual discharge
- c. a low pressure discharge for use
- d. a high pressure discharge solely connected to a jet to operate the same
- e. the jet forcing water from deep well into the suction of the centrifugal pump
- f. the water entering the suction of the pump being divided by the inherent characteristics of the pump casing design, and part discharging through low pressure discharge for use and part discharging through high pressure discharge to operate the jet

Consequently, we submit that the trial Court did not err in finding that the patents lacked invention.

Thus, if the accused devices come within the claims of the patent in suit, then the prior Veronesi pump also comes within those claims, and the claims are invalid as anticipated and cannot be infringed by the accused devices.

Obviously, the appellant was unable to meet this 1913 Veronesi patent, Exhibit M, squarely and the issue as to whether or not it completely anticipated the alleged inventions as claimed in the patents in suit

because in its brief it says not one word with respect to this Veronesi patent except:

“the Veronesi patent of 1913 cannot be used for purposes of anticipation because not pleaded or otherwise introduced in advance of trial as required by 35 U.S.C.A. Section 69.”

In other words, appellant attempts to waive off this patent and the Court's application thereof and its clear showing as an anticipation on the grounds that it was not properly pleaded. This is in error, as clearly pointed out in the first part of this title.

If one desired to use a pump having its impellers in series instead of in parallel it was only necessary to select such a pump from the prior art and substitute it for the pump of the 1913 Veronesi patent, Exhibit M, which would require no invention and which would not modify the pumping system one iota.

The Court so found (R. 80):

“12. Multi-pressure centrifugal pumps of multi-stage character with the impellers in series and having a discharge at an earlier impeller stage to discharge part of the water thereat while directing the remainder of the water through the remaining stages and discharge were old in the art long prior to the suit and are exemplified in the prior patents to Veronesi, No. 260,417, Sulzer, No. 704,144, Rateau, No. 730,842, Stepanoff, No. 2,248,312, Ensslin, No. 1,494,595 and Schmid (British), No. 382,592, Defendants' Exhibits Nos. N, O, P, Q, R and V, respectively.”

“27. The pumping systems claimed in claims 1, 2, 4, 5, 6, 7, 8 and 9 of patent in suit No.

“21. That the Italian patent to Veronesi, No. 260,417, Defendants’ Exhibit N, clearly discloses on its face the obvious presence of a low-pressure discharge opening communicating with the first impeller stage of the centrifugal pump for a low-pressure discharge to service.

“22. There are no dotted lines in the Veronesi patent drawing showing a passage through the pump casing from the chamber surrounding the first impeller to the discharge opening. But, the only reasonable purpose of the flow arrow drawn from the impeller chamber to the opening clearly indicates that the passage is there. Although dotted lines may be the standard method of indicating such pasageways, they are not always so used. This is significantly demonstrated by the drawings of plaintiff’s own patents in suit Nos. 2,424,285 and 2,344,958, where plaintiff failed to indicate at least one obvious passageway in his drawings, either by dotted lines or a flow arrow.

“23. The presence of a low-pressure discharge opening and passageway from the chamber of the first impeller stage of the centrifugal pump disclosed in Veronesi patent No. 260,417, Defendants’ Exhibit N, is not negatived by the statement in the specification of that patent to the effect that water after being raised to the desired pressure is divided into two portions, one portion being directed to the place of utilization and the other to the injector.”

(R. 86):

“29. The pumping system described in claims 1, 2, 4, 5, 6, 7, 8 and 9 of patent No. 2,344,958 is

the precise system clearly disclosed in the prior Italian patent No. 260,417 to Hugo Veronesi, Defendants' Exhibit N."

The above findings clearly find that the system which is claimed as novel in the two patents in suit was clearly and unequivocally shown in the early Italian patent to Veronesi No. 260,417. These findings were based upon substantial evidence and, therefore, should not be set aside. The evidence upon which the findings are based is as follows:

With reference to the Veronesi 1927 patent, both Dr. Folsom and Mr. Layne, both pump engineers with long experience, testified that the disclosure therein was perfectly clear to them and they could readily and accurately determine the construction and mode of operation thereof without any information other than furnished by the patent itself. (Mr. Layne, R. 397, 398; Dr. Folsom, R. 324, 325.)

These witnesses testified positively that the disclosure of that patent clearly teaches an engineer by the drawing conventions and by the specifications thereof that the centrifugal pump has a low pressure discharge from the first stage and a high pressure discharge from the last stage. Also, that the low pressure discharge is for use—the high pressure discharge to operate the jet. This is the exact operation of the accused pumps as well as the precise function of the patented pumps as claimed in the patents in suit.

The physical pump casing (Exhibit Y) is a silent witness to the complete and logical reasoning of these

witnesses. This pump casing (Veronesi Deposition) (R. Vol. III) was actually built many years ago by Veronesi, the patentee, as part of his business in manufacturing pumps.

Opposite this page we include an illustration of the pump illustrated in the Veronesi patent, Exhibit N, R. 559, in accordance with the testimony and have placed statements thereon corresponding in substance to Dr. Folsom's and Mr. Layne's testimony.

Also, for the Court's convenience, we make a verbal side by side comparison of the Veronesi 1927 patent (Exhibit N) (R. 552) disclosure and the accused pumps.

**Veronesi 1927 Patent
(Exhibit N)**

Accused Pumps

a. a multi-stage centrifugal pump (R. 304)

a. a multi-stage centrifugal pump

b. having a high pressure discharge from the last stage to the jet (R. 306)

b. having a high pressure discharge from the last stage to the jet

c. water under influence of the jet is supplied to suction of the centrifugal pump (R. 306)

c. water under influence of the jet is supplied to suction of the centrifugal pump

d. water passes through first stage of centrifugal pump (R. 307)

d. water passes through first stage of centrifugal pump

e. water from first stage goes into surrounding chamber (R. 307)

e. water from first stage goes into surrounding chamber

f. a portion of the water then discharging at low pressure through low pressure discharge (R. 307)

f. a portion of the water then discharging at low pressure through low pressure discharge

g. the remainder of the water passing through the last stage and being discharged under high pressure solely to the jet (R. 307)

h. inherently self-balancing in that subsequent stages are maintained submerged in water flowing by gravity from a chamber into which first stage empties before passing to low pressure discharge (R. 305)

i. no control valve necessary because of facts set out in "h" above.

g. the remainder of the water passing through the last stage and being discharged under high pressure solely to the jet

h. inherently self-balancing in that subsequent stages are maintained submerged in water flowing by gravity from a chamber into which first stage empties before passing to low pressure discharge

i. no control valve necessary because of facts set out in "h" above.

Thus, if the accused pumps are equal to the Veronesi disclosure and are included in the patent claims, then those claims include the Veronesi disclosure and are invalid as found by the trial Court.

Appellants' engineer (and patentee), Armstrong, agrees that the construction of the passage which both Dr. Folsom and Mr. Layne said the Veronesi patent conventionally illustrated between the chamber of the first stage and the low pressure outlet was the logical construction. See Mr. Armstrong's deposition, pages 153 and 154 as follows:

"Q. And please answer this with the understanding that it is an assumption:

On the assumption that there is a passage communication between the discharge outlet 9 and the register chamber between 'G' and 'J', or just externally of the diffusion vein, then that passage would extend radially downward,

wouldn't it, from 'G' out through 9, isn't that so?

* * * * *

A. I would say that would be the logical way to do it. It could be done by running it tangentially between two of the bolt holes.

* * * * *

Q. Now, the passageway that you are speaking of would be the passage between the arrows that I am marking on the drawing, and which I am marking 'K', is that right, Mr. Armstrong?

A. Yes." (Exhibit AJ-6.)

Dr. Folsom testified that no other construction of the pump of Veronesi 1927 patent was indicated at all. He testified (R. 323) as follows:

"Q. Now, Doctor, is there anything, conventional or otherwise, in the drawing of the Italian patent as Exhibit N, as shown in N-2 that indicates, discloses or suggests that the water may come from any other point to discharge from 9 except the first stage?

A. I find no such indication on the drawing."

The testimony of Dr. Folsom and Mr. Layne was not rebutted by appellant. An attempt so to do was made by the use of an *admittedly* erroneous and deceptive drawing attributing a falsified construction to the pump entirely foreign to the clear disclosure of the patent. Both Mr. Armstrong's and Mr. Granberg's testimony was based upon this *admittedly erroneous, deceptive and inaccurate* drawing and, therefore, such evidence is entitled to no weight. Mr. Armstrong's admission that the drawing upon which

their rebuttal was based was erroneous and deceptive is as follows (R. 472):

“Q. So there isn’t any such wall, a, as shown in Exhibit 21 in N-2, is there?

A. Well, a and b could be the same wall in this case here.

Q. But they are not shown as the same wall in 21, are they? You said they contacted the boss in the bottom a moment ago and that is the way it is illustrated?

A. That is right.

Q. So to that extent, in order to make the drawing 21, you had to violate the construction shown in N-2 right on the very face of the drawing, didn’t you?

A. It would appear that way.

Q. So that your testimony that 21 is an accurate illustration of the Italian patent N-2 is entirely erroneous, isn’t that so, to that extent?

A. To that extent, yes.

Q. As a matter of fact, Mr. Armstrong, this drawing, No. 21, is completely deceptive as far as the illustration of the structure shown in the Italian patent N-2 is concerned, to that extent, isn’t it?

A. To that extent. It reads on the specifications, though.”

Mr. Granberg, far from a pump expert, would have the Court believe that the same convention used on both the drawing of the Veronesi patent (Exhibit N) and the patent in suit No. 2,424,285 would prevent passage of water where such passage was obviously intended. See his testimony. (R. 440-441.)

Measuring Granberg's biased demeanor and qualifications against those of Dr. Folsom and Mr. Layne the trial Court rejected Granberg's illogical testimony based on an erroneous and deceptive drawing and accepted the logical, and frank and clear-cut testimony of Dr. Folsom and Mr. Layne.

The Court upon this evidence found as above set forth that this Veronesi patent anticipated the patents in suit and the latter were invalid for want of invention.

We point out (R. 323-324) Dr. Folsom's testimony that this 1927 Veronesi patent (which claims novelty in the jet only, which jet is different from 1913 Veronesi) has the same mode of operation as the Veronesi 1913 patent (Exhibit M), excepting the design details of the centrifugal pump which is a matter of selection for the engineer. This testimony is as follows:

“Q. Now, with respect to Exhibit N-2, the Italian patent N, the Italian patent M, and the drawing M-2, is there or is there not any substantial difference between the mode of operation of the two pumping systems shown therein?

A. The mode of operation for pumping in the two systems is the same.

Q. Will you point out the differences in the two systems, if any?

A. The differences are involved in the arrangement of the centrifugal pumps, involved in the system. If its—in this one all fluid passes through the first stage, so that it is a series arrangement. Part of the fluid being taken off at this first stage. The remainder of the fluid passing

through, returning for its drive pipe, 2—that is in Exhibit M-2. In Exhibit N-2. In Exhibit M-2, the water is separated before it passes into the impellers of the centrifugal pump, instead of after passing through the first stage of the centrifugal pump. The mode of operation, which is an increase in pressure through the action of the centrifugal pump, occurs in both of the centrifugal pumps, the difference is in the arrangement.

Q. And are both plans from an engineering viewpoint feasible or not?

A. They are both feasible.

Q. And the difference is then, as I understand it, it is a difference in question of selection of a design or not?

A. It is a matter of design on the part of the engineer, as to which way he wishes to arrange the pump.”

In that Dr. Folsom testified (R. 303-304) that the accused pumps had the same mode of operation as the Veronesi 1913 disclosure (except for pump construction details), it logically follows from the above that the accused pumps also follow the teachings of the 1927 Veronesi patent.

We submit that the findings of fact of the Court that the Veronesi patent, Exhibit N, discloses the precise system claimed in the patents in suit and discloses a pump having substantially the same construction and mode of operation as claimed in these patents are based not only upon substantial evidence, but the overwhelming weight of the evidence and,

consequently, these findings should not be set aside and the trial Court should not be found to have committed error in so finding and concluding.

APPELLANT'S CONTENTION THAT THE PATENTS IN SUIT DISCLOSE A NEW COMBINATION IS DIRECTLY CONTRARY TO THE FACTS AS FOUND BY THE TRIAL COURT AND THE FACTS SHOWN BY THE RECORD.

Appellant contends (appellant's brief page 47):

“Plaintiff's systems involve a plurality of elements so co-related and assembled as to provide new combinations which have achieved new, improved, useful and beneficial results.”

This is far from the facts as conclusively established by the record and found by the District Court. As the Court specifically found, the result achieved by the patents in suit was simply supplying high pressure water from the last stage of the centrifugal pump of the system to the jet and low pressure water from a stage preceding the last stage to service for use. These findings are (R. 85):

“24. The claims of patent in suit No. 2,344,958 are intended and purport to cover the idea of isolating the injector so that it alone is supplied from the last impeller stage, and providing a service discharge from an impeller stage other than that from which the injector is supplied.

“25. Claims 1, 2, 4, 5, 6, 7, 8 and 9 of patent No. 2,344,958 all describe a pumping system in which a pump unit with its impellers in series is

tapped at an early impeller stage to feed a service line and at a subsequent impeller stage of higher pressure to feed an injector assembly and these claims differ only in details not germane to the question of invention.”

Thus, the only result achieved is the supplying of low pressure water from one stage of the pump for use and high pressure water from the last stage of the pump solely delivered to the injector. This result, as the record shows and as the Court found, was an old result in jet pumps embodying the same combination, to-wit, a multi-stage centrifugal pump having its highest pressure stage delivered solely to the jet and its lowest pressure stage delivered solely for use. The District Court so found as follows (R. 82):

“16. Prior art Italian patent No. 139,161, Defendants’ Exhibit M, discloses a multi-stage centrifugal pump with sets of impellers in parallel and an injector. The intake water is divided as it enters the pump, part going to one set of impellers and discharged for use at low pressure, the remainder going to the second set of impellers and discharged under a higher pressure solely to supply the injector.”

Thus, this Italian patent, Exhibit M, discloses the complete combination of the two patents in suit as claimed, except for the fact that the impellers of the multi-stage centrifugal pump are in parallel rather than in series. *This is not contradicted by any evidence submitted by appellant and is the only evidence in the case.* (See page 37 of this brief.)

The Court also found (R. 82):

“17. Prior patent to Speck No. 376,684, Defendants’ Exhibit U, is similar in all respects to the system of Italian patent No. 139,161, Defendants’ Exhibit M, except the discharge to use is at a pressure higher than the discharge to the injector.”

It will be noted that in this patent for some reason the pressure for use was wanted at a higher pressure than the pressure necessary to operate the jet or injector, but except for this, this is identical with the patents in suit, even including a pressure tank and an automatic switch which is pressure operated.

The Court also found as to the Schmid patent, Defendants’ Exhibit V (R. 82), as follows:

“18. The Schmid patent No. 382,592, Defendants’ Exhibit V, discloses the basic idea of feeding a service discharge line from one impeller at one pressure and feeding the injector from a succeeding impeller at a higher pressure.”

In Finding 19 (R. 83) the Court found that the pumping system disclosed in Veronesi, Defendants’ Exhibit N, was composed of the same combination of elements as claimed in the patents in suit and achieved precisely the same result by the use of a centrifugal pump with the impellers *in series* as is the centrifugal pump of the patents in suit.

Thus, in at least three prior patents the entire combination of the patents as claimed is shown except for the specific fact that the pumps in Exhibit M and

and Exhibit U have the impellers in parallel instead of in series. The Court then went on to find, however, that substituting an old and well-known multi-stage centrifugal pump having the impellers in series with a discharge from a low pressure impeller and a discharge at its last stage impeller; that is to say, a low pressure and a high pressure discharge for the pumps in these old systems, would not amount to invention (R. 91):

“46. The pumping systems claimed in the claims of patent No. 2,424,285 would be substantially duplicated without invention merely by connecting an injector to one of the high-pressure discharge connections of the old and well known multi-discharge centrifugal pumps such as shown in patents Nos. 704,144; 730,842; 2,248,312 and 1,494,595, Defendants' Exhibit Nos. O. P. Q and R.”

Thus, if there is any combination at all of old elements in the patents in suit, it is an old exhausted combination completely shown in the prior art. Appellant complains that these prior patents fail to show the precise method of appellant's dividing the water within the pump, but the Court found as a fact in Finding 12 (R. 80) and Finding 8 (R. 79) that multi-pressure centrifugal pumps of multi-stage character with impellers in series and having a discharge at an earlier impeller stage to discharge part of the water thereat while directing the remainder of the water through the remaining stages and discharge were old in the art, and also that the specific means which the

patents in suit disclose for dividing the water within the pump between the discharges thereof was also old in the art.

Therefore, the combination, if any is specified by the claims, is an old and exhausted combination and is unpatentable. Under similar facts this Court has recently so held in *Gomez v. Granat*, 177 Fed. (2d) 266, wherein the Court stated:

“In the instant case the interlocking ensemble was well known, and the dovetail joint was well known to the art. No new or unexpected result was obtained and hence we think the patent is invalid for lack of invention.”

Obviously, no invention resides in appellant's pumping system because it is completely, fully and entirely met by the prior art and anticipated thereby, as found by the District Court.

THE DISTRICT COURT'S FINDINGS THAT THE CLAIMS OF THE PATENTS IN SUIT "ARE SO BROADLY DRAWN" AS TO INCLUDE VIRTUALLY EVERY POSSIBLE SYSTEM IN WHICH A MULTI-PRESSURE DISCHARGE IS SUPPLIED FROM A PUMP WITH AN EJECTOR ATTACHED ARE FINDINGS OF INVALIDITY OF THE PATENTS BECAUSE THE CLAIMS ARE FUNCTIONAL, AMBIGUOUS, INDEFINITE AND FAILING TO COMPLY WITH R.S. 4888.*

The defense that the claims of the patents in suit are so broad as to be invalid under R.S. 4888 was pleaded in appellees' answer to the complaint (R. 18) and raised in the counterclaim (R. 27 and 28) and denied in Answer to Counterclaim (R. 34).

The trial Court in Findings of Fact 41 and 42 (R. 90) on this issue and separate defense found as follows:

"41. That claims 3, 9 to 14, inclusive, 17 and 18 of patent No. 2,424,285 are so broadly drawn as to include virtually every possible system in which a multi-pressure discharge is supplied from a pump with an ejector attached.

"42. Claims 1, 2, 4 to 8, 15 and 16 of patent No. 2,424,285 are so broadly drawn as to include

*Revised Statutes § 4888:

"Before any inventor or discoverer shall receive a patent for his invention or discovery he shall make application therefor, in writing to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. * * *"

virtually every possible system in which a multi-pressure discharge is supplied from a pump with an ejector attached, and which include virtually every possible means for dividing the input to the pump between a discharge outlet and the injector to assure an operating supply to the injector.”

These are findings of invalidity because the claims are functional, ambiguous, indefinite and fail to comply with R.S. 4888. As we will point out to the Court at the end of this title in this brief, the appellant does not specify in its specification of errors that the Court erred in making such findings of fact, which are findings of fact of invalidity of the claims.

Claims of a character such as those in issue and found by the District Court to be so broadly drawn as to include virtually every possible system to accomplish the results of the patents in suit have been uniformly held invalid ever since 1853, commencing with the case of *O'Reilly v. Morse*, 15 How. 62, 112 (1853), 14 L. Ed. 601 (the telegraph case), in which our Supreme Court held:

“He (Morse) claims the exclusive right to every improvement where the motive power is the electric or galvanic current, and the result is the marking or printing intelligible characters, signs, or letters at a distance. If this claim can be maintained, it matters not by what process or machinery the result is accomplished. For aught that we know, some future inventor, in the onward march of science, may discover a mode of writing or printing at a distance by means of the electric or galvanic current, without using any

part of the process or combination set forth in the plaintiff's specification * * *"

See also:

Risdon v. Medart, 158 U.S. 68, 77, 15 S.Ct. 745,
39 L.Ed. 899.

To the same end is the leading case of *General Electric Co. v. Wabash Appliance Corporation et al.*, 304 U.S. 364, 58 S.Ct. 899 (1938), in which the Court held:

"* * * But Congress requires, for the protection of the public, that the inventor set out a definite limitation of his patent; that condition must be satisfied before the monopoly is granted.
* * *"

Universal Oil Products Co. v. Globe Oil & Refining Co., 322 U.S. 471, 64 S.Ct. 1111:

"* * * The claim is required to be specific for the very purpose of protecting the public against extension of the scope of the patent. (Citing cases)."

Boyden Power-Brake Co. et al. v. Westinghouse et al., *Westinghouse et al. v. Boyden Power-Brake Co. et al.*, 170 U.S. 537, 707 (1898):

"The difficulty we have found with this claim is this: That, if it be interpreted simply as a

claim for the function of admitting air to the brake cylinder directly from the train pipe, it is open to the objection (held in several cases to be fatal) that the mere function of a machine cannot be patented.”

Holland Furniture Co. v. Perkins Glue Co., 277
U.S. 245, 474 (1928).

Otis Elevator Co. v. Pacific Finance Corporation,
71 Fed. (2d) 641 (C.C.A. 9):

“* * * Although it is true, as petitioner suggests, that a function is not patentable because it is not within the patentable subject-matter defined in Rev. St. Sec. 4886 (35 U.S.C.A. Sec. 31), it is also true that a patent claim may be invalid for insufficiency of description under section 4888, because it describes the invention in terms of function or result without sufficient description of the means devised to accomplish that function or result. (Citing cases.)”

Otis Elevator Co. v. Pacific Finance Corporation et al., 68 Fed. (2d) 664 (C.C.A. 9, 1934).

“Even a casual reading of the claim and the master’s finding discloses that the invalidity was not merely because of indefiniteness, but because it covered only a function.”

B. B. Chemical Co. v. Cataract Chemical Co.,
112 Fed. (2d) 526 (C.C.A. 2, 1941).

*United Carbon Co. et al. v. Binney & Smith
Co.*, 317 U.S. 228, 63 S.Ct. 165.

American Lava Co. et al. v. Steward et al., 155
Fed. 731 (C.C.A. 6, 1907);
Kalle & Co. et al. v. Multazo Co., Inc., 109 Fed.
(2d) 321 (C.C.A. 6, 1940).

Following all these cases is the case of

*Halliburton Oil Well Cementing Company v.
Walker et al.*, 71 U.S.P.Q. 175 (decided Nov.
18, 1946), Sup. Ct.

“Under these circumstances the broadness, ambiguity, and overhanging threat of the functional claim of Walker become apparent. What he claimed in the court below and what he claims here is that his patent bars anyone from using in an oil well any device heretofore or hereafter invented which combined with the Lehr and Wyatt machine performs the function of clearly and distinctly catching and recording echoes from tubing joints with regularity. Just how many different devices there are of various kinds and characters which would serve to emphasize these echoes, we do not know. The Halliburton device, alleged to infringe, employs an electric filter for

this purpose. In this age of technological development there may be many other devices beyond our present information or indeed our imagination which will perform that function and yet fit these claims. And unless frightened from the course of experimentation by broad functional claims like these, inventive genius may evolve many more devices to accomplish the same purpose. See *United Carbon Co. et al. v. Binney & Smith Co.*, 317 U.S. 228, 236 (55 U.S.P.Q. 381, 385-386); *Burr v. Duryee*, 1 Wall. 531, 568; *O'Reilly, et al. v. Morse, et al.*, 15 How. 62, 112-13. *Yet if Walker's blanket claims be valid, no device to clarify echo waves, now known or hereafter invented, whether the device be an actual equivalent of Walker's ingredient or not, could be used in a combination such as this, during the life of Walker's patent.*

Had Walker accurately described the machine he claims to have invented, he would have had no such broad rights to bar the use of all devices now or hereafter known which could accent waves. For had he accurately described the resonator together with the Lehr and Wyatt apparatus, and sued for infringement, charging the use of something else used in combination to accent the waves, the alleged infringer could have prevailed if the substituted device (1) performed a substantially different function; (2) was not known at the date of Walker's patent as a proper substitute for the resonator; or (3) had been actually invented after the date of the patent. *Fuller v. Yentzler*, supra, at 296-97; *Gill v. Wells*, supra, at 29. Certainly, if we are to be consistent with Rev. Stat. 4888, a patentee cannot obtain greater coverage by failing to describe his inven-

tion than by describing it as the statute commands.”

This Court of Appeals in *Farmer's Cooperative Exchange, Inc. v. Turnbow et al.*, 111 Fed. (2d) 728, followed the rule. In that case the Court said:

“Claim 8, of the claims in question, is one of the most specific. It is: ‘A non-lethal parasiticide for internal administration, for intestinal parasites, comprising the combination of a nicotine substance in a dose normally parasiticidal to said parasites and lethal to the subject being treated on ingesting the same alone, and an organic colloid, said organic colloid rendering said dose non-lethal to the subject being treated and leaving it parasiticidal to said parasites.’

* * * * *

* * * As said in *General Electric Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 368, 58 S. Ct. 899, 901, 82 L. Ed. 1402: “* * * Recognizing that most inventions represent improvements on some existing article, process, or machine, and that a description of the invention must in large part set out what is old in order to facilitate the understanding of what is new, Congress requires of the applicant “a distinct and specific statement of what he claims to be new, and to be his invention.” (35 U.S.C.A. § 33.) Patents, whether basic or for improvements, must comply accurately and precisely with the statutory requirement as to claims of invention or discovery. * * *

The claims here violate that rule, and are void because ‘conveniently functional language at the exact point of novelty’ is used. *General Electric Co. v. Wabash Appliance Corp.*, supra, 304 U.S.

371, 58 S. Ct. 903, 82 L. Ed. 1402. See, also *Wood v. Underhill et al.*, 46 U.S. 1, 4, 5 How. 1, 4, 12 L. Ed. 23; *The Incandescent Lamp Patent*, 159 U.S. 465, 474, 16 S. Ct. 75, 40 L. Ed. 221.

In this connection appellees in attempting to distinguish *General Electric Co. v. Wabash Appliance Corp.*, supra, contend that 'each and every of these claims specify the ingredients as well as the quantity or proportion of such ingredients'. We are unable to agree with that contention. *An entire class of ingredients is specified not specific 'ingredients'*. The quantity or proportion of the class is not specified except 'in conveniently functional language'.

The instant case is one illustrative of the practice followed in many patents. The inventors experimented with and compounded particular alkaloidal substances with particular colloidal substances. Instead of confining their claims to that which they actually discovered, if anything, they attempted to monopolize all parasiticides which could be made from the entire class of alkaloidal substances with the entire class of colloidal substances."

A further case in point is *Heidbrink et al. v. McKesson*, 290 Fed. 665 (C.C.A. 6, 1923). One claim in controversy was as follows:

"2. A gas-administering device having a mixing chamber, means for supplying thereto from independent sources of supply a plurality of gases each under pressure and in fixed proportions at their respective pressures, means for controlling the respective pressures at which the several gases are delivered to the mixing chamber, and means

for definitely regulating and determining the aggregate volume of flow of said gases into the mixing chamber at their respective pressures while maintaining said fixed proportions.

* * * * *

With this statement of the situation, we come to his two claims of 1,265,910. We are compelled to think that they are invalid because functional. They are apparently most deliberately and skillfully drafted to cover any means which any one ever may discover of producing the result; that is, to accomplish the one thing while avoiding the other. We think they are clearly to be condemned under the rule stated in *O'Reilly v. Morse*, 15 How. 62, 112, 14 L. Ed. 601, *Risdon v. Medart*, 158 U.S. 68, 77, 15 Sup. Ct. 745, 39 L. Ed. 899, and the many familiar cases applying the rule, and that they are not within the principle of the *Telephone Case*, 126 U.S. 1, 634, 8 Sup. Ct. 778, 31 L. Ed. 863."

Refrigeration Patents Corporation v. Stewart-Warner Corporation (C.C.A. 7), 159 Fed. (2d) 972, at 976.

"As an answer to this contention, the *Halliburton* case, *supra*, states: '*Patents on machines which join old and well-known devices with the declared object of achieving new results, or patents which add an old element to improve a pre-existing combination, easily lend themselves to abuse. And to prevent extension of a patent's scope beyond what was actually invented, courts have viewed claims to combinations and improvements or additions to them with very close scrutiny.* * * * *It is quite consistent with this*

*strict interpretation of patents for machines which combine old elements to require clear description in combination claims. * * ** Cogent reasons would have to be presented to persuade us to depart from this established doctrine.'

Appellees say that 'neither defendant, nor anyone else, need have any difficulty in determining whether its coil is so constructed and operated as to be non-frosting * * *.' Since a 'non-frosting coil' is a desired *result*, and not a means, it seems evident to us that patentees should be entitled at most only to their particular inventive means to achieve that result, not every possible means which may be conceived in the future to achieve the same result. As the Supreme Court said in the Halliburton case, *supra*: 'In this age of technological development there may be many other devices beyond our present information or indeed our imagination which will perform that function and yet fit these claims. And unless frightened from the course of experimentation by broad functional claims like these, inventive genius may evolve many more devices to accomplish the same purpose. * * *.'''

We have discussed these findings of invalidity to show the Court that such findings are not erroneous. There is no specification in appellant's brief that the Court erred in so finding, nor does the appellant anywhere in its brief argue that these findings were in error in finding the claims invalid under R.S. 4888 as pleaded. Therefore, appellant has waived his right to assert error as to these findings and the conclusion of the trial court of invalidity of the patents should be

affirmed. This makes the remainder of the contentions of error as to other separate defenses raised by appellant moot.

Appellant recognized the effect of the above findings because in its statement of points on appeal (R. 490) it sets forth that the Court erred—

“3. In finding that Claims Nos. 1, 2 and 4 through 9 of said patent No. 2,344,958 are so broad that they define no invention and are invalid;”

and erred

“8. In finding that Claims Nos. 3, 9 to 14, 17 and 18 of said patent No. 2,424,285 are so broad that they define no invention and are invalid;”

However, appellant's failure to specify error as to these findings in its brief, or to argue the matter therein with respect to R.S. 4888, constitutes a waiver of its right to contend that the findings are in error, as has been frequently held by this Court.

A case on all fours is the case of *Mason v. Anderson-Cottonwood Irr. Dist.*, 126 Fed. (2d) 921, decided by this Court March 21, 1942. In that case the alleged error appeared in the statement of points filed by appellant but was not mentioned in the specification of errors, in the brief, or argued therein, and this Court refused to consider such error, stating:

“But one other matter need be noticed. In the district court appellant filed a statement of points in which he designated twenty-two errors proposed to be relied on upon the appeal. Point 14 was that ‘the Court erred in fixing a period of

twelve months within which creditors of the district must present their claims to the registrar for payment pursuant to the plan of composition, in that such term should not be restricted to the period of twelve months.' However, in his specification of errors in this brief appellant failed to mention this point, nor did he touch upon it in any way until the oral argument.

"Our rule 20, subdivision 2(d), provides that the brief shall contain 'a specification of errors relied upon which shall be numbered and shall set out separately and particularly each error intended to be urged.' In view of the failure to specify the point or to argue it in the brief, the alleged error will not be considered.

"Affirmed."

An earlier case to the same point was decided by this Court, which is the case of *Bank of Eureka v. Partington*, 91 Fed. (2d) 587, the Court stating:

"There are four assignments of error. Assignment 1 is not argued or discussed in appellant's brief and is, therefore, deemed to have been abandoned. *Forno v. Coyle* (C.C.A. 9) 75 F. (2d) 692, 695. Appellant's brief states:"

See also the case of *Humphreys Gold Corporation v. Lewis*, 90 Fed. (2d) 896, wherein the Court stated:

"There are nine assignments of error. Two of the assigned errors (assignments 1 and 2) are not specified in appellant's brief, as required by our rule 24, and are, therefore, disregarded. *Mutual Life Ins. Co. v. Wells Fargo Bank & Union Trust Co.* (C.C.A. 9) 86 F. (2d) 585, 587; *United States*

v. Los Angeles Soap Co. (C.C.A. 9) 83 F. (2d) 875, 889; Hultman v. Tevis (C.C.A. 9) 82 F. (2d) 940, 941; Berry v. Earling (C.C.A. 9) 82 F. (2d) 317; Gelberg v. Richardson, (C.C.A. 9) 82 F. (2d) 314, 315; Gripton v. Richardson (C.C.A. 9) 82 F. (2d) 313, 314.”

THE DISTRICT COURT FOUND AS A FACT “CLAIM 13 OF PATENT NO. 2,424,285 IN SUBSTANCE IS IDENTICAL WITH THOSE CLAIMS IN PATENT NO. 2,344,958 WHICH DO NOT SPECIFY THAT THE DISCHARGE OPENING TO SERVICE IS VALVE FREE” AND IT THEREFORE FOLLOWS AS A MATTER OF LAW THAT PATENT NO. 2,424,285 IS INVALID FOR DOUBLE PATENTING.

The District Court found as a fact on the issue of double patenting raised by paragraph VI of Answer to Complaint (R. 19) as follows:

“6. The claims of the two patents in suit fail to express clearly the line of division between them, and one must resort to the specifications to determine it; for example, claim 13 of patent No. 2,424,285 in substance is identical with those claims in patent No. 2,344,958 which do not specify that the discharge opening to service is valve free.”

Manifestly, it follows, as a matter of law, from this finding of fact that the later patent, which is No. 2,424,285 is invalid.

Appellant did not specify the above finding of fact by the District Court as error in its specification of errors and makes no attempt in its opening brief to controvert it or show that there was any evidence to

the contrary or that it was not supported by substantial evidence. Consequently, the judgment of invalidity of this patent appealed from should be affirmed.

It is clear from the record of this case that Letters Patent No. 2,424,285 is invalid because, as the District Court found as a fact, both patents have identical claims and claims of the later patent cover the same pump structure claimed in the earlier Letters Patent No. 2,344,958 and, therefore, appellant is guilty of double patenting.

For the convenience of the Court we set out claim 13 referred to by the Court of patent no 2,424,285, which appears at R. 503, and claim 5 of patent No. 2,344,958, which appears at R. 509.

**Claim 13 of Patent
No. 2,424,285**

A pump system for a well, comprising a pump unit having a plurality of stages stacked for operation in series, with each stage feeding into the succeeding stage in the series;

a suction line connected to the input of said pump unit;

an injector assembly in said suction line and including a venturi and a nozzle;

a pressure line connecting said nozzle to said pump unit at a point of high discharge pressure;

and a discharge connection from said pump unit with a

**Claim 5 of Patent
No. 2,344,958**

A pump system for a well, comprising a pump unit having a plurality of stages in series, from which discharge at any one of a number of pressures may be taken;

a suction line connected to the input of said pump unit;

an injector assembly in said suction line and including a venturi and a nozzle;

a pressure line connecting said nozzle to said pump unit at a point of high discharge pressure; a pressure chamber;

and a discharge connection to said pressure chamber from

pressure value lower than that to said nozzle by an amount sufficient to maintain said injector assembly operative at the lowest normal level of water in said well.

said pump unit at a pressure value lower than that to said nozzle by an amount sufficient to maintain said injector assembly operative at the lowest normal level of water in said well.

We call the Court's attention to the fact that the only difference between these two claims of the two patents is that claim 5 of the earlier patent is slightly narrower than that of No. 2,424,285 in that it includes the non-essential limitation of a pressure chamber (admittedly old in the art) to which the low pressure discharge from the pump is connected.

That these claims are of identically the same scope in substance is uncontrovertible, and clearly claim 13 of the later issued patent, which issued in 1947, would include the pumping system defined in claim 5 of the earlier issued patent, issued in 1944, and extend the monopoly approximately three years on the pump shown in the earlier 1944 patent No. 2,344,958. This is clearly a case of double patenting and clearly evidences the fact that the District Court committed no error in its finding of fact No. 6 (R. 78) that "claim 13 of patent No. 2,424,285 in substance is identical with those claims in patent No. 2,344,958 which do not specify that the discharge opening to service is valve free".

The Supreme Court has clearly expressed the rule of double patenting in the case of *Miller et al. v. Eagle Manuf'g Co.*, 151 U.S. 186, 14 S.Ct. 310, where it stated:

“* * * If, upon a proper construction of the two patents,—which presents a question of law to be determined by the court, (*Heald v. Rice*, 104 U.S. 749), and which does not seem to have been passed upon and decided by the court below,—they should be considered as covering the same invention, then the later must be declared void, under the well-settled rule that two valid patents for the same invention cannot be granted either to the same or to a different party.

“Thus, in *Manufacturing Co. v. Hayden*, 3 Wall. 315, it was held that where two patents, showing the same invention or device, were issued to the same party, the later one was void, although the application for it was first filed: thereby deciding that it is the issue date, and not the filing date, which determines priority to patents issued to the same inventor or the same machine.”

* * * * *

“In *McCreary v. Canal Co.*, 141 U.S. 467, 12 Sup. Ct. 40, it was held that where a party owned two patents, showing substantially the same improvement, the second was void; the court saying: ‘It is true that the combination of the earlier patent in this case is substantially contained in the later. If it be identical with it, or only a colorable variation from it, the second patent would be void, as a patentee cannot take two patents for the same invention.’”

* * * * *

“The result of the foregoing and other authorities is that no patent can issue for an invention

actually covered by a former patent, especially to the same patentee, although the terms of the claims may differ; * * *”

* * * * *

“* * * it must distinctly appear that the invention covered by the later patent was a separate invention, distinctly different and independent from that covered by the first patent; in other words, it must be something substantially different from that comprehended in the first patent. It must consist in something more than a mere distinction of the breadth or scope of the claims of each patent.”

Under this standard, as announced by the Supreme Court, it is conclusive that the appellant in the instant case is guilty of double patenting. Additionally is this fact found by the District Court without error, because appellant's own witness, one of the patentees of the patents in suit, testified that the only difference between the devices disclosed in the two patents was the elimination in the later patent No. 2,424,285 of a control valve. This testimony was adduced in answer to questions put to the witness by the Court at R. 462, where the appellant's witness Armstrong stated:

“Q. Exhibit 3 cannot be operated without a mechanical device?

A. From this discharge, yes, your Honor. This discharge does not require a mechanical device.

Q. You said that the main difference in the teaching of Exhibit 4 was that it eliminated the

mechanical device; it saves on the time of adjustment, the people going out there to look at it?

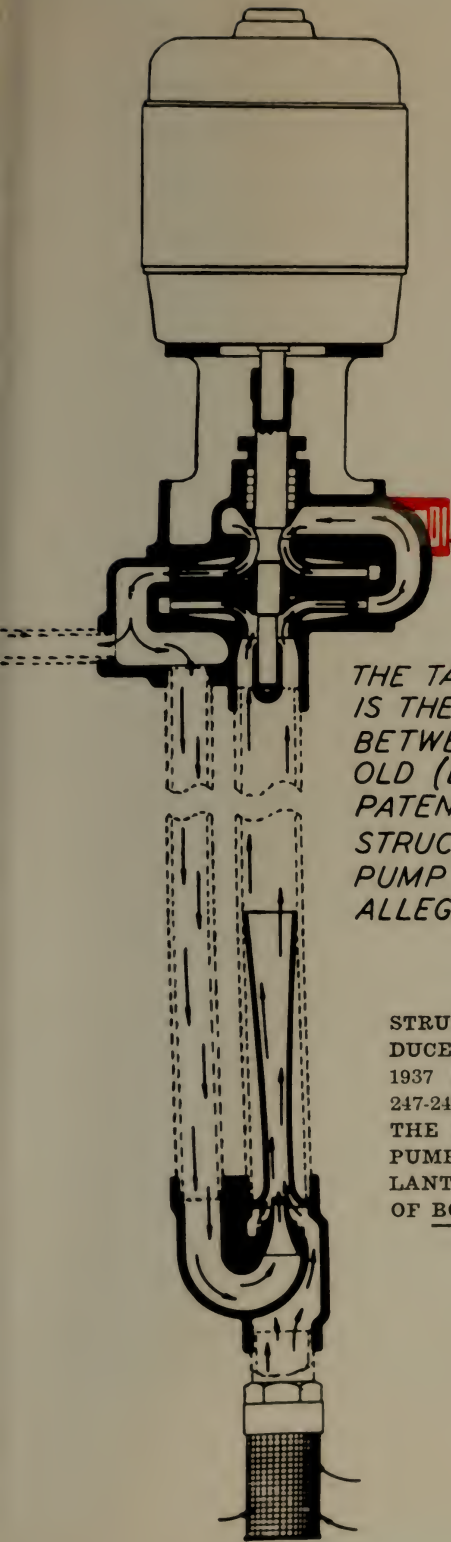
A. That is right."

Therefore, the only difference between the two systems of the two patents is that in one a control valve is eliminated. This is a distinction without a difference because the trial Court found as a fact (Finding 7, R. 78):

"The absence of control valves in the patented system is unimportant because merely removing the control valves accomplishes nothing in itself."

This amply demonstrates that the alleged invention covered by the later patent No. 2,424,285 is not substantially different or distinct from the invention covered by the earlier issued patent, and under the rule of the *Eagle Manufacturing Co.* case heretofore cited, the later issued or second patent No. 2,424,285 is invalid as unlawfully extending the patent monopoly beyond seventeen years, as provided by statute, to twenty years.

That the claims of the two patents in suit *in fact* cover the *same alleged invention* is clear from appellant's own contention that the simple change in appellees' own prior art pump (1937—(R. 247-248) not charged to infringe as it precedes by many years the patents in suit) *infringes both patents in suit*. This change is graphically illustrated on the illustration opposite this page. Isn't it manifestly clear that if the *claims of both patents* in suit include this simple change in appellees' pump, that both patents cover



THE TAPPED OPENING IN RED IS THE ONLY DIFFERENCE BETWEEN DEFENDANTS OLD (LONG PRIOR TO PATENTS IN SUIT) PUMP STRUCTURE AND THE PUMP STRUCTURES HERE ALLEGED TO INFRINGE

STRUCTURE SHOWN IN BLACK IS REPRODUCED FROM DEFENDANTS' EXHIBIT I 1937 APPELLEES' PRIOR ART PUMP (R. 247-248). BY THE SIMPLE ADDITION OF THE TAPPED OPENING (RED) THIS OLD PUMP IS CONVERTED INTO WHAT APPELLANT CONTENDS INFRINGES THE CLAIMS OF BOTH PATENTS IN SUIT.

the *exact same alleged invention*? Just how appellant can contend that the claims of both patents cover such a simple thing and still cover separate and distinct inventions is beyond our comprehension.

Therefore, the evidence is conclusively clear that double patenting exists and that there was no error on the part of the District Court in its finding of fact. Again the appellant has not specified in its brief or argued therein that the Court erred in so finding, and, therefore, such finding should not be disturbed.

In this instance it is again true that the appellant recognized that the finding above quoted constituted a finding of invalidity of patent No. 2,344,958 on the grounds of double patenting because in its statement of points on appeal (R. 491) it included the following point:

“12. In finding that Claim No. 13 of said patent No. 2,424,285 in substance is identical with those claims in said patent No. 2,344,958 which do not specify that the discharge opening is valve free;”

Not having specified or argued in its brief that there is any error in such finding, appellant waived such error and the finding should stand unmolested on the basis of the authorities quoted and cited on pages 67-68 of this brief.

Again we urge that appellant has attempted to show error in only certain of the independent grounds relied upon by the trial Court to show invalidity not connected with this defense. Thus, this defense

is a valid one and ample by itself to support the District Court's final conclusion that patent No. 2,424,285 is invalid, rendering the remainder of the contentions of error of appellant on appeal moot.

**THERE IS NO CONFLICT IN THE FACTS FOUND
BY THE TRIAL COURT.**

The appellant in its brief attempts, by a play on words, to show conflicting findings by the trial Court. This can only be done by giving certain statements of the trial Court in its opinion a strained interpretation. Likewise, appellant insists throughout its brief in comparing details of construction of their pumping system as actually drawn in the patent with the Court's findings of fact and conclusions, rather than *the definitions of alleged invention as contained in the claims in the patents.*

In attempting to find conflict in the statement of facts appellant, on page 42 of its brief, says:

“* * * the District Court found:

“ ‘Multi-pressure centrifugal pumps of the type just described are old in the art. But of the specific models brought to the Court's attention, *none were designed specifically to supply water at different pressures simultaneously.*’ (R. 58) ”.

From this statement appellant attacks the findings of fact of the Court that these pumps could be substituted in any old system to accomplish the results

of the patents without invention. The fact that none of these pumps were designed specifically for that purpose is unimportant because the record and the Court's findings of fact are that without changing the construction or mode of operation of those pumps, they can be so inserted in such systems by merely connecting the injector to the high pressure discharge and the discharge for service to a lower stage of the pump.

The fact that such a system would be inherently stable and self-balancing is obvious from the testimony discussed elsewhere in this brief, because the fact that the pumps are horizontal, renders them inherently stable and inherently self-balancing because the eye of the last impeller is always maintained submerged and will not be starved of water. As a matter of fact, if appellant complains that this is a difference of the prior patent, then the same difference exists between the accused pumps because they obtain inherent stability and self-balancing by precisely the same medium as shown in the record by the findings of fact of the Court (see Findings 10 and 11).* (R. 79 and 80.)

*"10. In the defendants' accused pumping system the force of gravity accomplishes the division of water between the low-pressure discharge outlet and the next succeeding impeller by arrangement of the eye of the said impeller at an elevation lower than the low-pressure discharge opening so that such impeller eye is always submerged and is fully supplied before water can flow through the low-pressure discharge opening.

"11. That defendants' accused pumping system does not employ the means of the patents in suit of positively dividing the water between a discharge opening tapping an impeller stage and the eye of the succeeding impeller, but instead arranges the eye

THE COURT SHOULD NOT BE MISLED BY APPELLANT'S ARGUMENT THAT APPELLEES' OBTAINING A PATENT ON THE PRECISE CONSTRUCTION OF THEIR CENTRIFUGAL PUMP IS A BASIS FOR INFERENCE THAT THE PATENTS IN SUIT ARE VALID OR EMBODY INVENTIONS.

Appellant attempts to bolster the patents in suit by the following misleading statement in its brief, page 57, as follows:

“If the inventions lacked novelty, as the defendants now contend, why did they seek letters patent thereon and why engage in an expensive interference proceeding;”

This statement is misleading and is not based on the record facts and, consequently, the inferences attempted to be drawn are without support. That statement is erroneous and misleading in the following particulars:

a. All of the claims of the Rhoda patent (a copy attached to Exhibit E—the file wrapper) (R. 536) include the particular low pressure chamber and pump details by means of which air separation is effected. Therefore, these claims, all except one (which was ultimately in interference and disclaimed by appellees) clearly are limited to the precise location and formation of appellees' low pressure pump chamber

of the impeller to be fed at a lower elevation than the discharge opening so that the force of gravity will keep the eye of the impeller submerged although water is discharging through the discharge opening, which use of the force of gravity for the same purpose was old and well known long prior to the patents in suit and is inherent in the pumps of prior art patents Nos. 730,842, 1,494,595 and 260,417, Defendants' Exhibits Nos. P. R. and N.”

by which air elimination is effected, and, consequently, are not in conflict with the structures shown in the patents in suit.

b. But one of the claims of the patent (which was very ambiguous and which the Patent Office ultimately held could also be read on the patents in suit) was the single issue of the interference which was declared by the Patent Office after *ex parte* urging by the appellant.

c. *Appellees did not engage in expensive or any interference* (contrary to the above statement of appellant) with the appellant. The file wrapper of such interference proceeding, Exhibit D, shows the following facts:

1. The Patent Office, after *ex parte* urging by the appellant, declared the interference between one claim of appellees' issued Rhoda patent and one of the applications for the patents in suit.

2. Promptly after such declaration of the interference, appellees, through their patent attorney by motions, attempted to have the interference dissolved and dismissed on the grounds that the claim in issue, while it read on appellees' structure, distinguished from the pump system disclosed in the appellant's patent in suit *because of the inclusion of the air elimination low pressure chamber above referred to*, which appellant's device does not have. An additional ground of the motion was that when interpreted to read on appellant's pump, the claim also read upon the Veronesi 1927 patent (Exhibit N here) which was not cited

in connection with the Rhoda application but located by appellees after the interference. In this motion appellees urged the Patent Office that the issue was unpatentable (when interpreted in the manner it was interpreted by the Patent Office) because it was completely anticipated by said Veronesi patent and was invalid and void. The patent attorney making such a motion was apparently unaware of the rule that the Patent Office has no power to hold a claim of a patent invalid and to dismiss an interference because the claim in issue is met by prior art.*

3. The appellees refused to engage in the interference and upon final adverse decision by the Patent Office as to the motions on the above grounds, completely disclaimed the single claim in issue from its patent because there was no reason to engage in any controversial interference proceeding respecting the alleged first inventorship of an invalid claim. The disclaimer appears in the file wrapper of the Rhoda patent at the end thereof which file wrapper is Exhibit D. Naturally, the interference proceeding in its entirety ceased with the filing of the disclaimer.

The above facts conclusively show, therefore, that the statement above quoted from appellant's brief that appellees *engaged in expensive interference over a void patent* is entirely without basis. Far from being

*In an interference involving a patent and an application, neither party is permitted to raise the question of patentability of a claim by a motion to dissolve. *Bellows v. King*, 1903 C.D. 328; *Sachs v. Ball*, 1927 C.D. 30; *Conradson v. Drake et al. v. Morgan*, 1927 C.D. 32.

expensive or an interference, it was a simple proceeding submitted on memorandum only. Therefore, the inferences which appellant would like to draw from the above facts fall of their own weight. As a matter of fact, even if the appellant was correct on its facts, the inferences it draws do not follow as a matter of law in view of the following cases:

Our Supreme Court clearly so ruled in *Paramount Public Corporation v. American Tri-Ergon Corporation*, 294 U.S. 464, 55 S. Ct. 449, at 455:

“* * * However inconsistent this early attempt to procure a patent may be with petitioner’s present contention of its invalidity for want of invention, *this Court has long recognized that such inconsistency affords no basis for an estoppel, nor precludes the court from relieving the alleged infringer and the public from the asserted monopoly when there is no invention. * * **”
(Emphasis ours.)

Also in *Haughey v. Lee et al.*, 151 U. S. 282, 285, 14 S.Ct. 331, 332, 38 L.Ed. 162, the Supreme Court held:

“* * * Besides, the defense of want of patentable invention in a patent operates, not merely to exonerate the defendant, but to relieve the public from an asserted monopoly, and *the court cannot be prevented from so declaring by the fact that the defendant had ineffectually sought to secure the monopoly for himself.*” (Emphasis ours.)

CONCLUSION.

In conclusion we respectfully submit that the trial Court's findings to the effect:

(1) that the alleged step in advance of the pumping system disclosed in the patents in suit did not constitute invention, but involved at most the exercise of mechanical skill;

(2) that the alleged inventions of the patents in suit as defined by the claims of those patents are clearly anticipated by the prior art and are invalid;

(3) that the difference between the pumping systems disclosed in the patents in suit and prior pumping systems is merely one of degree and did not involve patentable invention;

(4) that the patents in suit do not disclose a patentable combination, but merely an old and exhausted combination of a pumping system including a centrifugal pump and a jet pump, and in that the entire combination being shown in the prior art and no novelty being found in any of the parts of such system, no invention existed therein;

(5) that the appellees' accused pumping structures follow the teachings of the prior art, and the claims of the patents in suit, if they embrace the accused pumping structures, also embrace the prior art structures and are invalid;

(6) that the claims of the patents in suit are so broad, ambiguous and indefinite that they do not comply with R.S. 4888 and are invalid;

(7) that the later issued patent No. 2,424,285 contains claims of the same scope as the claims of the earlier issued patent and thereby unlawfully extends the monopoly on the alleged inventions and is invalid; are not clearly erroneous, are all supported by substantial evidence, and should not be disturbed on this appeal.

We respectfully submit that the judgment appealed from should be affirmed.

Dated, San Francisco, California,

October 25, 1950.

Respectfully submitted,

MELLIN, HANSCOM & HURSH,

OSCAR A. MELLIN,

LEROY HANSCOM,

JACK E. HURSH,

Attorneys for Appellees.

